Supreme Court, U.S.
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In the

Supreme Court of the United States

THE READ CORPORATION,
F.T. READ & SONS, INC. AND
NORDBERG-READ, INC.,
PETITIONERS,

v.

POWERSCREEN OF AMERICA, INC.,
POWERSCREEN INTERNATIONAL
DISTRIBUTION, LTD. AND
POWERSCREEN INTERNATIONAL, PLC,
RESPONDENTS.

On Petition for Writ of Certiorari to The United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

JACK R. PIROZZOLO
Counsel of Record for Petitioners
JUDITH S. ZISS
RICHARD L. BINDER
WILLCOX, PIROZZOLO & MCCARTHY
PROFESSIONAL CORPORATION
50 Federal Street
Boston, MA 02110
(617) 482-5470

Blanchard Press, Inc., Boston, Mass. – Law Printers (617) 426-6690

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QUESTIONS PRESENTED FOR REVIEW

1. When viewed in the context of both the increasingly limited scope of jury participation on the question of patent infringement and the Federal Circuit's "assault on the doctrine of equivalents,"[1] did the Federal Circuit violate the patentee's rights under the Seventh Amendment and intrude upon the province of the jury in resolving a quintessential fact issue when it overturned a jury verdict of infringement under the doctrine of equivalents?

2. Where a competitor did not challenge the sufficiency of evidence as to infringement by equivalents by motion for JMOL before the jury returned its verdict of infringement, did the Federal Circuit violate patentee's rights under the Seventh Amendment and violate Fed. R. Civ. P. 50 when it reviewed the jury verdict of infringement for substantial evidence, ordered entry of judgment for the competitor, and did not consider ordering, or permitting the district court to order, a new trial?

3. Should the Federal Circuit have adhered to the regional circuit's procedural rule for determining whether a pre-verdict JMOL motion pursuant to Fed. R. Civ. P. 50 preserved an issue for determination by the court?

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[1] *Johnson & Johnston Associates Inc.* v. *R.E. Service Co.*, 285 F.3d 1046, 1064 (Fed. Cir. 2002) (Newman, J., dissenting).

PARTIES TO PROCEEDING

The full name of all parties to the proceeding are Petitioners:

The Read Corporation
F.T. Read & Sons, Inc.
Nordberg-Read, Inc.,

and Respondents:

Powerscreen of America, Inc.
Powerscreen International Distribution, Ltd.
Powerscreen International, PLC

The Read Corporation and F.T. Read & Sons, Inc. are now JLR Corporation.
Nordberg-Read, Inc. is now Metso Minerals (Middleboro), Inc.

Counsel for Respondents have represented that Powerscreen of America, Inc. is now Powerscreen USA LLC.

All parent corporations and publicly-held companies that own 10 percent or more of the stock of any Petitioner are:

Metso Minerals (Milwaukee), Inc., Metso Minerals USA, Inc., and Metso Oy.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED FOR REVIEW	i
PARTIES TO PROCEEDING	ii
TABLE OF CONTENTS	iii
TABLE OF AUTHORITIES	v
CITATION TO REPORTS OF OPINIONS AND ORDERS ENTERED IN THE CASE	1
STATEMENT OF THE BASIS FOR JURISDICTION	1
CONSTITUTIONAL PROVISION AND RULES INVOLVED IN THE CASE	1
STATEMENT OF THE CASE	1
ARGUMENT	10
APPENDIX	
OPINION BELOW	A-1
Majority Opinion	A-1
Dissent	A-18

JUDGMENT APPEALED FROM
AND OTHER ORDERS

Final Judgment Of The United States District Court For The District Of Massachusetts, May 29, 2001 A-27

Excerpt From Transcript Of Hearing On Post-Trial Motions, United States District Court For The District Of Massachusetts, May 17, 2001 A-29

Order Of The United States Court Of Appeals For The Federal Circuit, October 10, 2002 A-33

Judgment Of The United States Court Of Appeals For The Federal Circuit, August 7, 2002 A-35

OTHER MATERIALS

Constitution of the United States, Amendment VII A-36

Rule 50, Federal Rules of Civil Procedure A-37

TABLE OF AUTHORITIES

Cases	Page(s)
Al-Site Corp. v. VSI International, Inc., 174 F.3d 1308 (Fed. Cir. 1999)	18
Ampex Corp. v. Mitsubishi Electric Corp., 173 F.3d 434 (Fed. Cir. 1998) (table)	17
Atlantic and Gulf Stevedores, Inc. v. Ellerman Lines, Ltd., 369 U.S. 355, reh. denied, 369 U.S. 882 (1962)	20
Augustine Medical, Inc. v. Gaymar Industries, Inc., 181 F.3d 1291 (Fed. Cir. 1999)	13, 17
Byrd v. Blue Ridge Rural Electric Cooperative, 356 U.S. 525, reh. denied, 357 U.S. 933 (1958)	20
Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303 (Fed. Cir. 1998)	13
Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182 (Fed. Cir. 1998)	18
Cone v. West Virginia Pulp & Paper Co., 330 U.S. 212 (1947)	22
Correa v. Hospital San Francisco, 69 F.3d 1184 (lst Cir. 1995), cert. denied, 517 U.S. 1136 (1996)	3, 24

Cases	Page(s)
Curtis Mfg. Co. v. Plasti-Clip Corp., 135 F.3d 778 (Fed. Cir. 1998)(table)	17
Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448 (Fed. Cir. 1998)	11, 18
Dawn Equipment Co. v. Kentucky Farms, Inc., 140 F.3d 1009 (Fed. Cir. 1998)	17
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 535 U.S. 722 (2002), vacating and remanding, 234 F.3d 558 (Fed. Cir. 2000)	14, 17
Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 72 F.3d 857 (Fed. Cir. 1995), vacated, 520 U.S. 1111 (1997)	10
Fiskars, Inc. v. Hunt Mfg. Co., 221 F.3d 1318 (Fed. Cir. 2000), cert. denied, 532 U.S. 972 (2001)	18
Forest Laboratories, Inc. v. Abbott Laboratories, 239 F.3d 1305 (Fed. Cir. 2001)	17
Graver Tank & Mfg. Co. v. Linde Air Products. Co., 339 U.S. 605, reh. denied, 340 U.S. 845 (1950)	13
Hoechst Celanese Corp. v. BP Chemicals Ltd., 78 F.3d 1575 (Fed. Cir.), cert. denied, 519 U.S. 911 (1996)	22, 23, 24

Cases	Page(s)
Holmes Group, Inc. v. Vornado Air Circulation Systems, Inc., 535 U.S. 826 (2002)	19
Interactive Pictures Corp. v. Infinite Pictures, Inc., 274 F.3d 1371 (Fed. Cir. 2001), cert. denied, ___ U.S. ___, 123 S.Ct. 112 (2002)	14, 18
Interactive Technologies, Inc. v. Pittway Corp., 194 F.3d 1337 (Fed. Cir.)(table), cert. denied, 528 U.S. 1046 (1999)	17
J.T. Eaton & Co. v. Atlantic Paste & Glue Co., 106 F.3d 1563 (Fed. Cir. 1997)	11
Johnson & Johnston Associates Inc. v. R.E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002)	i, 12, 13, 14, 17
Katz v. City Metal Co., 87 F.3d 26 (lst Cir. 1996)	15
Kinzenbaw v. Deere & Co., 741 F.2d 383 (Fed. Cir. 1984), cert. denied, 470 U.S. 1004 (1985)	23
Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855 (Fed. Cir. 1988), cert. denied, 490 U.S. 1068 (1989)	16
Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313 (Fed. Cir. 1999), cert. denied, 528 U.S. 1075 (2000)	18

Cases	Page(s)
LRC Electronics, Inc. v. John Mezzalingua Associates, Inc., 194 F.3d 1337 (Fed. Cir. 1999)(table), cert. denied, 528 U.S. 1075 (2000)	17
Malta v. Schulmerich Carillons, Inc., 952 F.2d 1320 (Fed. Cir. 1991), reh. denied, 959 F.2d 923, cert. denied, 504 U.S. 974 (1992)	23
Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996)	10
Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir. 1995), aff'd, 517 U.S. 370 (1996)	10
Montgomery Ward & Co. v. Duncan, 311 U.S. 243 (1940)	22, 24
Neely v. Martin K. Eby Construction Co., 386 U.S. 317, reh. denied, 386 U.S. 1027 (1967)	25
Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565 (Fed. Cir. 1986)	23
Riles v. Shell Exploration and Production Co., 298 F.3d 1302 (Fed. Cir. 2002)	18
Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420 (Fed. Cir. 1997)	14
Sextant Avionique, S.A. v. Analog Devices, Inc., 172 F.3d 817 (Fed. Cir. 1999)	18

Cases	Page(s)
Snellman v. Ricoh Co., 836 F.2d 528 (Fed. Cir. 1987)	23
Southwest Software, Inc. v. Harlequin Inc., 226 F.3d 1280 (Fed. Cir. 2000)	22, 23
Steamfeeder, LLC v. Sure-Feed Systems, Inc., 175 F.3d 974 (Fed. Cir. 1999)	17
Strub v. Axon Corp., 168 F.3d 1321 (Fed. Cir. 1998)(table)	17
Texas Instruments Inc. v. Cypress Semiconductor Corp., 90 F.3d 1558 (Fed. Cir. 1996), cert. denied, 520 U.S. 1228 (1997)	23
Tronzo v. Biomet, Inc., 156 F.3d 1154 (Fed. Cir. 1998)	17
Ultrak, Inc. v. Radio Engineering Industries, Inc., 215 F.3d 1339 (Fed. Cir. 1999)(table)	18
Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17 (1997)	13, 14, 17
Weisgram v. Marley Co., 528 U.S. 440 (2000)	25
WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339 (Fed. Cir. 1999)	13
Zodiac Pool Care, Inc. v. Hoffinger Industries, Inc., 206 F.3d 1408 (Fed. Cir. 2000)	14, 18

Constitution and Statutes	Page(s)
Constitution of the United States, Amendment VII	i, 1, 10, 20, 21, 22, 24
28 U.S.C. § 1254	1
28 U.S.C. § 1331	1
28 U.S.C. § 1338(a)	1
35 U.S.C. § 112	13
35 U.S.C. § 112, ¶6	17
35 U.S.C. § 271(f)	22

Court Rules	Page(s)
Fed. R. Civ. P. 50	i, 1, 2, 21, 23, 24, 26
Fed. R. Civ. P. 50(a)	2
Fed. R. Civ. P. 50(a)(2)	21
Fed. R. Civ. P. 50(b)	22, 25
Fed R. Civ. P. 50, Advisory Committee Notes to 1991 Amendment	21, 22, 24

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CITATION TO REPORTS OF OPINIONS AND ORDERS ENTERED IN THE CASE

The opinion of the United States Court of the Appeals for the Federal Circuit, dated August 7, 2002, which was not selected for publication in the Federal Reporter, can be found at 44 Fed.Appx. 502 and at 2002 WL 1822282. It is reproduced in the Appendix to this Petition at A-1 to A-26.[1]

STATEMENT OF THE BASIS FOR JURISDICTION

The judgment sought to be reviewed was entered by the United States Court of Appeals for the Federal Circuit on August 7, 2002.

Timely Petitions for Rehearing and for Rehearing En Banc from the judgment were denied on October 10, 2002 (A-34).

Jurisdiction of this Court to review the judgment by writ of certiorari is based upon 28 U.S.C. § 1254.

CONSTITUTIONAL PROVISION AND RULES INVOLVED IN THE CASE

Constitution of the United States, Amendment VII, is set forth in the Appendix to this Petition at A-36.

Fed. R. Civ. P. 50 is set forth in the Appendix to this Petition at A-37-38.

STATEMENT OF THE CASE

1. This is an action for patent infringement under the doctrine of equivalents. Jurisdiction in the district court was based upon 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a). The case was tried to a jury.

[1] References to A-___ are to the Appendix to this Petition. References to A ___ are to the Joint Appendix on Appeal.

After a thirteen day trial, the jury found United States Letters Patent 4,237,000 (the "'000 patent") was willfully infringed by Respondents Powerscreen of America, Inc., Powerscreen International Distribution, Ltd., and Powerscreen International, PLC ("Powerscreen"). It awarded damages to Petitioners The Read Corporation, F.T. Read & Sons, Inc., and Nordberg-Read, Inc. ("Read") of $14,483,320 (A101898-1900). All motions pursuant to Fed. R. Civ. P. 50 for judgment as a matter of law ("JMOL") were denied (A-27-31). Judgment entered, including double damages, pre-judgment interest, and attorney's fees, in the amount of $34,921,739.09 (A-28).

Powerscreen appealed. The United States Court of Appeals for the Federal Circuit, with one judge dissenting, concluded "that the evidence was not sufficient to support the jury's finding that Powerscreen infringed the '000 patent under the doctrine of equivalents ..." (A-12). Read unsuccessfully petitioned for rehearing and for rehearing *en banc* (A-34).

2. Read brought this action alleging infringement of the '000 patent.[2] Read also alleged that Powerscreen induced infringement of that patent. At the close of Read's evidence, Powerscreen moved for JMOL pursuant to Fed. R. Civ. P. 50(a) solely on inducement to infringe (A000113-15; see A100106-16). Inducement was an alternate theory pertaining only to devices first manufactured in late 1997 (A101227).[3] Powerscreen did not raise the sufficiency of evidence of infringement of the '000 patent either literally or under the doctrine of equivalents. At the close of the evidence, Powerscreen filed a "renewed" motion for JMOL, which raised no issues pertaining to the '000 patent (A000182-201).

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[2] Read also alleged infringement of a second patent. The jury found no infringement. That patent is no longer at issue.

[3] Read claims that Powerscreen began infringing the '000 patent as early as 1990.

Subsequently, Powerscreen filed two post-verdict JMOL motions (A000281-311), raising for the first time the issues, other than inducement to infringe, which it relied upon in the Federal Circuit. In denying these motions, the trial judge stated: "If the doctrine of equivalents has any remaining vitality, this is a case where the doctrine of equivalents is appropriately applied" (A-30).

3. The Federal Circuit held that Powerscreen did not waive "its challenge to the sufficiency of the evidence of the jury's verdict of infringement" (A-2-3). It acknowledged that the "primary focus of Powerscreen's Rule 50(a) motion" was directed toward the inducement issue (A-2). In finding an absence of waiver, it relied upon general boiler-plate language "[i]n the introduction, in a section heading, and in the conclusion of its motion" (A-3). Although the Federal Circuit normally relies upon law of the regional circuit for resolution of procedural issues, it declined to do so here, saying that the issue "relates particularly to patent law" (A-3, n.1). First Circuit precedent provides that an issue not "distinctly articulated" in a pre-verdict JMOL motion is waived. See, e.g., *Correa* v. *Hospital San Francisco*, 69 F.3d 1184, 1196 (lst Cir. 1995), *cert. denied*, 517 U.S. 1136 (1996).

4. The patent in suit concerns portable screening plants that separate fine materials such as sand and loam from coarse materials such as rocks, boulders, and construction debris. Screening plants are used in construction, excavation, and waste handling.

The '000 patent (A200203-210) claims a critical component, the shaker assembly that includes vibrating shaker screens (A100396-97). These are upper and lower screens shaken by a diesel engine.

In the prior art, screening was carried out by a two-step process. Large rough material was separated from smaller rough material by large static "grizzly" bars.

Finer material then was transported to long narrow screening plants, called "dinosaurs," for further separation.

The Read screening plant turned a two-step process into a single operation. A payloader deposits material directly on the upper of two vibrating shaker screens. Finer material passes through the screens into a three-sided enclosure. Coarse material cascades down the screens and falls outside. The plant is equipped with a hitch and is easily towed by truck or trailer along a public highway.

In the prior art, screens were about two and one-half times as long as they were wide (A100164). In contrast, the Read screens, which perform both the "grizzly" and "dinosaur" functions, are wider than they are long (A100303-304, A200208 at col. 1:63-64). These wide screens led to a new problem, out-of-phase vibration, which was solved by the shaker assembly of the '000 patent.

Originally, the Read machine had a conventional shaker assembly, consisting of upper and lower screens supported by crossbeams with the screens stretched between sideplates (A200208 at col. 1:64). During normal screening operations, the shaker assembly bounces on springs in a rotary movement through operation of a heavy off-balance shaft mechanism driven by a hydraulic motor and must withstand the tremendous forces generated in this process (A200208-09 at col. 1:67-2:2; 3:11-14, 4:12-25). This motion results in out-of-phase vibration of the screening decks. If the screening decks are not structurally united, this out-of-phase vibration causes fatigue and cracking of the welds of the crossbeams supporting the screens (A100222-23, 100332-33). Prior to the invention of the '000 patent, the Read device could not operate for more than a few hours before it was destroyed by damage from out-of-phase vibration (A100316-17; *see*

also A100222-23, A100333, A100479-81).

The '000 patent claims a shaker assembly with a longitudinal centerplate parallel to the sideplates. The centerplate transmits forces from the upper deck to the lower deck and the joined crossbeams. It ensures proper distribution of the forces throughout the structure and prevents independent out-of-phase vibration which would destroy the screens (A200208-10; A100316-17; *see also* A100222-23, 100333, 100479-81).

After the centerplate was added to the Read device, the product became a commercial success. It created a new market for contractors attempting on-site screening at construction sites involving extremely coarse material (A100365-69, 100437-41, 100482, 100577-78, 200312-14).

5. Claim 1 of the '000 patent provides:

> In a shaker assembly for separating fine material from coarse material comprising longitudinal side plates, structural cross beams joining the side plates, a screen assembly spanning the space between the side plates and supported by the cross beams, and means for shaking the plates, cross beams and screen assembly, the improvement of:
>
> an upper screen assembly supported on an upper level of cross beams and a split lower screen assembly supported on a lower level of cross beams; and
>
> at least one rigid longitudinal center plate generally parallel to and between the side plates and joining the upper and lower levels of structural cross beams such that forces applied to the screen assembly are transmitted through the center plate to the joined cross beams.

A200209-210. Only the last paragraph is at issue.

6. Powerscreen sold screening devices in the United States as well as in Europe. Outside the United States, where Read had no patent protection, Powerscreen used

a centerplate which admittedly would infringe the '000 patent. In devices exported to the United States it substituted unified joined centerplates (A101592-93).

Beginning in the middle of 1990, the unified joined centerplates consisted of three components. These were upper and lower centerplates joining the cross beams and welded to a backplate, plus an additional piece of steel, or gusset. This gusset, which was located at the backplate and was perpendicular to it, spanned the short distance between the upper and lower centerplates. The gusset was welded to both the upper and lower centerplates at the backplate, thus joining them (A200661-62, 200822, A201585-86; see also A101231-33, A100907, A101192-1202, A101224-25, A101228-29). In 1994 Powerscreen made a minor change by making the joining gusset part of one of the centerplates (A101201, 101233). The unified joined centerplates were made of steel and extended longitudinally from the upper to the lower edge of the screens (A101204, A200661-62).

Based upon the evidence introduced at trial, the jury concluded that the unified joined centerplates were the equivalent of "at least one rigid longitudinal center plate generally parallel to and between the side plates and joining the upper and lower levels of structural cross beams such that forces applied to the screen assembly are transmitted through the center plate to the joined cross beams." Drawings of the unified joined centerplates showed the centerplate structure. Testimonial evidence included admissions in the deposition testimony of Neill Suitor, the Powerscreen engineer responsible for designing the Powerscreen device, and expert testimony of Read's witness, Professor Alexander Slocum. Key portions of this testimony are set forth below.

7. The Federal Circuit analyzed the Suitor admissions and Slocum testimony in detail to determine whether "substantial evidence" supported the jury verdict of infringement by equivalents.

During his testimony, Mr. Suitor was shown drawings of the unified joined centerplates used in the United States version of the device, referred to as Exhibit 1, and a drawing of the unitary centerplate used in the European version, referred to as Exhibit 2 (A101191-92). He was asked why the structure used in the United States version was "included in the screen box at all" (A101193):[4]

A: It's used to connect the cross beams which run transversely to each other.
Q. Does it strengthen the screen?
A: Yes.
Q. How does it strengthen the screen box?
A. It rigidly connects the cross beams on each deck and transmits the force from one to the other and into the back plate.

A101193. The Federal Circuit majority determined that "one to the other" referred to the multiple individual crossbeams "within each level" (A-8-9). The dissent disagreed, stating that "Mr. Suitor's testimony could be interpreted to mean that the center plates transmit 'the forces from one [deck] to the other [deck] and into the back plate' " (A-25).

Mr. Suitor also was asked whether "screens that are built in accordance with Suitor Exhibit 1 [the U.S. design] perform any differently to the screens built in accordance with Suitor Exhibit 2 [the European design]" (A-9-10; also see 101194). He responded, "No." *Id.* His testimony then continued:

Q: Do they perform substantially the same way?

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[4] See footnote 2 in the Federal Circuit opinion regarding the typographical error in the transcript, erroneously identifying the exhibit (A-8, n.2).

A: Yes.

.....

Q: Do they achieve substantially the same result?

A: Yes.

Q: Is one as reliable as the other?

A: Sometimes.

Q: Would you please explain your answer?

A: Sometimes the machine which has the center plate can have structural failure and sometimes the other machine can have structural failure. There is, there is no real common denominator.

Q: You did not trace a difference in structural failure to whether or not the screening box has the center plate of the type that Suitor Exhibit 1 is or the type that Suitor Exhibit 2 is?

A: Not directly.

A101194-95. This interrogation referenced Suitor Exhibit 1 and Suitor Exhibit 2 (A200661-63), which were drawings of the centerplates in the two versions of the Powerscreen device rather than drawings of the screens. The Federal Circuit majority rejected this testimony, saying: "It is clear that both the questions posed by counsel and Mr. Suitor's responses are directed solely to a comparison of the reliability and performance of the large and small mesh screens of the U.S. and European Powergrid models, not to a comparison of the two different centerplate designs" (A-10).

8. These admissions of Mr. Suitor, the designer of the Powerscreen device, were supplemented by Read's expert witness, Professor Slocum. He testified that the unified joined centerplates "inefficiently performed the function" of the rigid longitudinal centerplate claim element (A100928-29). When asked "what was the way in which it performed that function," he responded:

A: The way in which it performed it was it actually had portions of metal that connected, physically, part of the top center plate to the bottom centerplate ...

A100929. The Federal Circuit majority quoted this testimony (A-6). Regarding "function," the majority concluded that Professor Slocum's testimony of "inefficient" infringement "undermines rather than supports a finding of equivalence" (A-6-7). Regarding Professor Slocum's "way" testimony, the Federal Circuit majority found Professor Slocum's testimony that "it actually had portions of metal that connected, physically, part of the top center plate to the bottom centerplate" to be "wholly deficient" (A-7).

The dissent pointed out that Professor Slocum's concession "that such a structure would be inefficient" was not a concession "that such a structure was not equivalent" (A-23-24). The dissent also pointed to additional testimony of Professor Slocum in response to questioning by the Court. When asked how the centerplate in the Kentucky [or accused device] differs from the centerplate as claimed, Professor Slocum, using his laser pointer to demonstrate, explained

What I find is here is a center plate that joins together all the upper cross ... But in the back lever is where—okay, then you see the center plate here joining the lower, the lower beams? And this fin that sticks up, so now it splits the lower screen into two, two individual screens. And right in the back here is where, if you will, the center plate for the top screen and the center plate for the bottom screen are actually welded together back there.

So what you get is a very inefficient, if you will, structure that will partially couple, via this particular center plate, the upper screen to the lower screen.

A-24; also see A100895-96). Looking at "Mr. Slocum's testimony taken as a whole," the dissent concluded it "provides sufficient evidence for the jury to conclude that the unbolted center plate design performs the function of the claimed center plate through their connection to the back of the screen box" (A-25). The dissent pointed out that "while Mr. Suitor and Mr. Slocum may have provided testimony that appears ambiguous or conflicting at times, our perception of these ambiguities may be a result of our having only a transcript to read" (A-26). Noting that the jury had the advantage of live testimony "accompanied by reference to documents and photographs," he cautioned that "it is their job, not ours to evaluate the contradictory evidence and draw inferences therefrom." *Id.* Unlike the majority, the dissent found the jury verdict supported by substantial evidence and would have affirmed. *Id.*

ARGUMENT

1. This case presents an erosion of the function of the jury, in violation of the Seventh Amendment to the Constitution. The role of the jury, and even the role of the district court, is being continually circumscribed in patent cases. The Federal Circuit has stated that its own decision in *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995), subsequently affirmed by this Court (*Markman* v. *Westview Instruments, Inc.* 517 U.S. 370 (1996)), "requires independent determination of the construction of the claims, as a matter of law, unencumbered by the trial process." *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 72 F.3d 857, 863 (Fed. Cir. 1995), *vacated,* 520 U.S. 1111 (1997). A judge of the Federal Circuit, referred, in dissent, to "the troubled intersection between legal and factual analyses in this court's post-*Markman* jurisprudence," complaining

that the Federal Circuit was "divorc[ing] the interpretive process from a host of inherently factual subsidiary matters, such as how one skilled in the art would understand claim terms and prosecution history statements" and asserting that the "court... overstepped the boundaries of effective appellate review." *J.T. Eaton & Co.* v. *Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1577 (Fed. Cir. 1997)(Rader, J., dissenting). It has been clear since *Cybor Corp.* v. *FAS Technologies, Inc.*, 138 F.3d 1448, 1451 (Fed. Cir. 1998), if not before, that a district court's claim construction is reviewed *de novo* by the Federal Circuit.

In 1999, Judge Michel of the Federal Circuit wrote:

> The role of summary judgment motions in modern patent cases is difficult to overestimate. Recent changes in claim construction methodology have increased the number of issues and, indeed, the number of cases amenable to final disposition on summary judgment. For example, once the asserted claims of a patent have been construed fully as to any disputed terms, the existence of literal infringement can frequently be determined as a matter of law because the structure and operation of the accused device are rarely subject to genuine evidentiary dispute. Similarly, proper construction of the scope of asserted claims will sometimes settle the issue of equivalent infringement as a matter of law because no reasonable jury could find that the substituted step or element is found equivalently in the accused process or device.

Michel, "A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit, Foreword: The Court of Appeals for the Federal Circuit Must Evolve to Meet the Challenges Ahead" 48 *Am. U. L. Rev.* 1177, 1187-88 (1999)(footnotes omitted). As Judge Michel analyzed the current state of the law:

> Theoretically, the only cases in need of trial would be those in which either the structure and operation of the accused device are unclear based on the summary judgment affidavits or depositions, or where there is a close question about whether the terms of the claim are met by the features of the accused device or steps in the accused process, literally or equivalently.

Id. at 1188-89.

A statistical study of the Federal Circuit's written decisions from January 1998 through April 2000 concludes that Judge Michel's "prediction has already come true." Chu, "Empirical Analysis of the Federal Circuit's Claim Construction Trends," 16 *Berkeley Tech. L.J.* 1075, 1092-93, 1108 (2001). The author found that 166 cases had been decided below on summary judgment while 109 were tried before a judge or jury. *Id.* at 1109[5]. In another study, which analyzed "ninety-four published patent opinions in the year 2000, fifty-one of them addressed issues of literal infringement." The authors found "the district court resolved the literal-infringement issues on a motion for summary judgment in thirty of them." Adamo *et al*, "Survey of the Federal Circuit's Patent Law Decisions in 2000: Y2K in Review," 50 *Am. U. L. Rev.* 1435, 1609 (2001).

2. At the same time, the Federal Circuit continues to impose new legal barriers to infringement under the doctrine of equivalents. Judge Newman made this point in her dissent in *Johnson & Johnston Associates Inc.* v. *R.E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002):

> Instead of deciding this appeal on the basis on which it reaches us—that is, whether to sustain the jury verdict that stainless steel and aluminum are equiv-

[5] The study, which focused on claim construction issues, analyzed written opinions and, for the most part, excluded summary affirmances. *Id.* at 1097 and ns. 105, 112, 121.

> alent substrates for copper foil laminates—my colleagues launch yet another assault on the doctrine of equivalents. The court today holds that there is no access to equivalency for any subject matter that is disclosed in a patent specification but not claimed. Thus the court establishes a new absolute bar to equivalency, a bar that applies when there is no prosecution history estoppel, no prior art, no disclaimer, no abandonment.
>
> The court overrules not only its own decisions but also those of the Supreme Court, and reaches out to create a new, unnecessary and often unjust, *per se* rule. ... It is self-evident that the placement of an increasing number of pitfalls in the path of patentees serves only as a deterrent to innovation.

Johnson, 285 F.3d at 1064 (Newman, J., dissenting).[6]

Judge Newman's conviction that the Federal Circuit had launched an assault against the doctrine of equivalents has ample basis in other Federal Circuit precedent. In *Chiuminatta Concrete Concepts, Inc.* v. *Cardinal Industries, Inc.*, 145 F.3d 1303, 1310 (Fed. Cir. 1998), the Federal Circuit held that the doctrine of equivalents is not available in an action for infringement of a means-plus-function claim under 35 U.S.C. § 112 unless the variant is "based on after-developed technology."[7] In *Augustine Medical, Inc.* v. *Gaymar Industries, Inc.*, 181 F.3d 1291, 1301 (Fed. Cir. 1999), the Federal Circuit jet-

[6] In her dissent, Judge Newman stated that the *Johnson* decision was in "egregious conflict" with this Court's decisions in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605, *reh. denied*, 340 U.S. 845 (1950), and *Warner-Jenkinson Co.* v. *Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

[7] The Federal Circuit has limited this rule to cases where the equivalency argument pertains to an allegedly equivalent "structure," distinguishing cases where the equivalency argument pertains to an allegedly equivalent "function." See *WMS Gaming, Inc.* v. *International Game Technology*, 184 F.3d 1339,

tisoned the long-standing rule that "pioneering inventions deserve a broader range of equivalents" than other patents. Cases such as *Sage Products, Inc.* v. *Devon Industries, Inc.*, 126 F.3d 1420, 1425 (Fed. Cir. 1997), and *Zodiac Pool Care, Inc.* v. *Hoffinger Industries, Inc.*, 206 F.3d 1408, 1416 (Fed. Cir. 2000), deny any scope of equivalence to "clear structural limitations" in a patent claim. *Johnson*, *supra*, in which Judge Newman's dissent appeared, barred a finding of equivalency where the accused subject matter is disclosed in the specification but not claimed.[8]

The Federal Circuit's imposition of a *per se* rule barring application of any range of equivalents to any claim element narrowed during patent prosecution was recently rejected by this Court in *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002), *vacating and remanding*, 234 F.3d 558 (Fed. Cir. 2000). The four judges of the Federal Circuit, who dissented from that Court's imposition of a complete bar on the ground that it was contrary to this Court's decision in *Warner-Jenkinson* v. *Hilton Davis Chemical Co.*, 520 U.S. 17 (1997) (234 F.3d at 598-642), presaged this Court's statement that the *Festo* majority "ignored the guidance of *Warner-Jenkinson*." 535 U.S. at ___, 122 S.Ct. 1831, 1841.

3. The diminishing role of the jury in patent litigation and the Federal Circuit's undisguised antipathy toward the doctrine of equivalents cross paths in the case at bar. The Federal Circuit acknowledged that it must consider "all the evidence in the light most favorable to ...

1353 (Fed. Cir. 1999); *Interactive Pictures Corp.* v. *Infinite Pictures, Inc.*, 274 F.3d 1371, 1381-82 (Fed. Cir. 2001), *cert. denied*, __ U.S. __, 123 S.Ct. 112 (2002).

[8] For a discussion of cases limiting the scope of the doctrine of equivalents, see Belvis, "An Analysis of the En Banc Decision in *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co. and the Doctrine of Equivalents*," 11 *Fed. Circuit B.J.* 59 (2001-2002).

the nonmoving party, without weighing the credibility of witnesses and without substituting our judgment for that of the jury in deciding factual issues on which there is conflicting evidence" (A-4). When the First Circuit, which is the regional circuit, reviews rulings on JMOL motions, it "examine[s] the evidence and all fair inferences in the light most favorable to the plaintiff [and] may not consider the credibility of witnesses, resolve conflicts in testimony, or evaluate the weight of the evidence." *Katz* v. *City Metal Co.,* 87 F.3d 26, 28 (lst Cir. 1996). The Federal Circuit violated these cardinal rules. Essentially, the Federal Circuit microanalyzed the testimony of the witnesses as if they were the words of a patent claim and then, insofar as it purported to find conflicts within the testimony, it sought to resolve them, as if it were interpreting an ambiguous patent claim in light of the specification and file history.

This faulty approach is particularly evident with respect to Mr. Suitor's testimony regarding transmission of forces within the accused structure. The manner in which forces were transmitted was a central issue in the case which could be resolved only through testimony. Mr. Suitor testified that the unified joined centerplates in the accused structure strengthen the screen box by "rigidly connect[ing] the cross beams on each deck and transmit[ting] the force from one to the other and into the back plate" (A101193). The dissent concluded that Mr. Suitor meant from one deck to the other while the majority concluded that Mr. Suitor meant from one cross beam to the other (Compare A-9 with A-25). Drawing inferences is for the jury, not for the Federal Circuit.

When Mr. Suitor was directed to exhibits showing the unitary centerplate of the European version of Powerscreen's device and the unified joined centerplates of the United States version, and conceded that they perform substantially the same way and achieve substantially the same result (A101194), the majority concluded

that Mr. Suitor was not referring to the centerplates but only to the mesh screens (A-10). It reached this conclusion by attempting to reconcile the Suitor testimony upon which Read relied with other testimony by Mr. Suitor. For example, the testimony which the majority quotes, where Mr. Suitor appears to deny equivalence, came immediately before the testimony upon which Read relies, where he acknowledged equivalence. Compare A-10-11 with A-9-10. The concession was made after Mr. Suitor, an adverse witness, was pressed on cross-examination (A101192-94). Rather than accepting a change in testimony as the result of cross-examination, the Federal Circuit sought to reconcile what it perceived as conflicting statements. Resolving conflicts in testimony is for the jury, not for the Federal Circuit.

Regarding Professor Slocum's testimony, where he pointed to and described the steel gusset and its function (see A-6 and A-24), the Federal Circuit failed to read all the testimony together. Regarding Professor Slocum's testimony that the accused structure performed the same "function" but "inefficiently," the Federal Circuit ignored its own rule that inefficient infringement is infringement nonetheless. *Laitram Corp.* v. *Cambridge Wire Cloth Co.*, 863 F.2d 855, 859 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1068 (1989).

4. A study has shown that the Federal Circuit's reversal rate in jury cases is no lower than its reversal rate in summary judgment cases, where the standard of review is less deferential. Indeed, of the cases in the study, the Federal Circuit affirmed only 45% of judgments after jury trials as compared to affirmances of 52% of summary judgments. Chu, *supra*, 16 *Berkeley Tech.L.J.* at 1111. The author attributes the figures to the Federal Circuit's *de novo* standard of review for claim construction where "it is free to substitute its own judgment for that of the lower court." *Id.*

However, at least in cases where a jury has found infringement under the doctrine of equivalents, a substantial proportion of jury verdicts have been overturned by the Federal Circuit on factual grounds unrelated to changed claim interpretations. During the period 1998 to the present, the Federal Circuit overturned jury verdicts of infringement under the doctrine of equivalents at least ten times,[9] more than half due to insufficient evidence.[10] In an additional five cases, the district court granted a motion for JMOL after the jury returned a verdict of infringement under the doctrine of equivalents and the Federal Circuit affirmed, with two of the five based upon insufficiency of the evidence.[11] The Federal

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[9] Where this Court vacated a decision of the Federal Circuit in light of *Festo, supra*, or *Hilton Davis, supra*, the decision is not included in this group of cases or the following groups. Similarly, decisions pertaining to means plus function claims are included only where the Federal Circuit viewed the patentee's claim as one for infringement under the doctrine of equivalents rather than as a claim for literal infringement under the statutory language. See 35 U.S.C. § 112, ¶6. Copies of unpublished opinions are being lodged with the Clerk.

[10] In addition to the case at bar, these are *Interactive Technologies, Inc.* v. *Pittway Corp.*, 194 F.3d 1337 (Fed. Cir.) (table), *cert. denied*, 528 U.S. 1046 (1999); *Curtis Mfg. Co.* v. *Plasti-Clip Corp.*, 135 F.3d 778 (Fed. Cir. 1998) (table); *Tronzo* v. *Biomet, Inc.*, 156 F.3d 1154, 1160 (Fed. Cir. 1998); *Dawn Equipment Co.* v. *Kentucky Farms, Inc.*, 140 F.3d 1009, 1017 (Fed. Cir. 1998); *Strub* v. *Axon Corp.*, 168 F.3d 1321 (Fed. Cir. 1998) (table). In *Johnson, supra*, 285 F.3d at 1054 (disclosed in specification), *Steamfeeder, LLC* v. *Sure-Feed Systems, Inc.*, 175 F.3d 974, 983-84 (Fed. Cir. 1999) (prior art), *LRC Electronics, Inc.* v. *John Mezzalingua Associates, Inc.*, 194 F.3d 1337 (Fed. Cir. 1999) (table), *cert. denied*, 528 U.S. 1075 (2000) (prior art), and *Augustine, supra*, 181 F.3d at 1294 (file wrapper estoppel), the Federal Circuit held that reliance on the doctrine of equivalents was precluded on legal grounds.

[11] These are *Forest Laboratories, Inc.* v. *Abbott Laboratories*, 239 F.3d 1305, 1313 (Fed. Cir. 2001), and *Ampex Corp.* v.

Circuit issued at least seven published or unpublished opinions in which it affirmed a jury verdict of infringement under the doctrine of equivalents, considering the sufficiency of the evidence in all but one.[12] This accords with the Chu survey, showing that where a jury verdict of infringement under the doctrine of equivalents was appealed to the Federal Circuit, there was at least as great a chance that the Federal Circuit would reverse rather than affirm. However, claim interpretation does not appear to be the explanation for the reversal rate in this class of cases.

A commentator has suggested that "Federal Circuit patent jurisprudence has occasionally demonstrated a tendency towards myopia," with the threat that it is "anoint[ing] itself a de facto court of last resort in patents." Janis, "Symposium: Intellectual Property Challenges in the Next Century; Patent Law in the Age of the Invisible Supreme Court," 2001 *U. Ill. L. Rev.* 387, 398, 402 (2001). Relying upon views expressed in

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Mitsubishi Electric Corp., 173 F.3d 434 (Fed.Cir. 1998)(table). Both *Sextant Avionique, S.A.* v. *Analog Devices, Inc.*, 172 F.3d 817, 826 (Fed. Cir. 1999) and *Loral Fairchild Corp.* v. *Sony Corp.*, 181 F.3d 1313, 1327-29 (Fed. Cir. 1999), *cert. denied*, 528 U.S. 1075 (2000), were primarily file wrapper estoppel cases. In *Zodiac*, *supra*, 206 F.3d at 1415-16, the court relied upon a new claim interpretation and its "clear structural limitations" doctrine.

[12] These are *Riles* v. *Shell Exploration and Production Co.*, 298 F.3d 1302 (Fed. Cir. 2002), *Interactive Pictures Corp.* v. *Infinite Pictures, Inc.*, *supra*, *Fiskars, Inc.* v. *Hunt Mfg. Co.*, 221 F.3d 1318 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 972 (2001), *Ultrak, Inc.* v. *Radio Engineering Industries, Inc.*, 215 F.3d 1339 (Fed. Cir. 1999) (table), *Comark Communications, Inc.* v. *Harris Corp.*, 156 F.3d 1182 (Fed. Cir. 1998), *Al-Site Corp.* v. *VSI International, Inc.*, 174 F.3d 1308 (Fed. Cir. 1999), and *Cybor*, *supra*, 138 F.3d at 1459-60. In *Cybor*, the sole issue was prosecution history estoppel. This group of cases does not include any summary affirmances which the Federal Circuit may have issued.

Commission on Revision of the Federal Court Appellate System, "Structure and Internal Procedures: Recommendations for Change," 67 F.R.D. 195, 235 (1975), sometimes known as the Hruska Commission Report, this commentator cautioned:

> For any "specialized" court that monopolizes a substantive area, one should be concerned about the possibility that the specialized court may have less incentive than corresponding generalist courts to develop and carefully articulate a defensible rationale for its decisions, knowing that no other sister tribunal will have the opportunity to pass on the same issue.

Id. at 403 and ns. 23, 71. In the commentator's view, this Court "might supply an important moderating influence over experts [on the Federal Circuit]." *Id.* at 404. In *Holmes Group, Inc.* v. *Vornado Air Circulation Systems, Inc.*, 535 U.S. 826 (2002), where this Court recently preserved jurisdiction of the regional circuits over patent cases when the patent issue arose in a counterclaim, Justice Stevens made the same point. Citing an earlier article, Dreyfuss, "The Federal Circuit: A Case Study in Specialized Courts," 64 *N.Y.U.L.Rev.* 1, 25-30, 54 (1989), it was pointed out:

> An occasional conflict in decisions may be useful in identifying questions that merit this Court's attention. Moreover, occasional decisions by courts with broader jurisdiction will provide an antidote to the risk that the specialized court may develop an institutional bias.

535 U. S. at __, 122 S.Ct. 1889, 1898 and n. 4 (Stevens, J.).[13]

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[13] Dreyfuss discerned a pro-patent bias in the Federal Circuit. 64 N.Y.U. L. Rev. at 26. A dozen years later, Janis con-

Petitioners respectfully suggest that the Federal Circuit has developed an institutional bias which leads it to decide questions *de novo*, with no deference to proceedings in the trial court, and that this bias has spilled over into the realm of factual findings by juries, particularly where juries have relied upon the doctrine of equivalents in finding infringement. Insofar as the Federal Circuit intrudes upon the province of the jury, it violates the Seventh Amendment. As stated in *Byrd* v. *Blue Ridge Rural Electric Cooperative*, 356 U.S. 525, 537, *reh. denied,* 357 U.S. 933 (1958):

> An essential characteristic of [the federal system] is the manner in which, in civil common-law actions, it distributes trial functions between judge and jury and, under the influence—if not the command—of the Seventh Amendment, assigns the decisions of disputed questions of fact to the jury.

Citing *Byrd*, this Court reversed the court of appeals in *Atlantic and Gulf Stevedores, Inc.* v. *Ellerman Lines, Ltd.*, 369 U.S. 355, 360, *reh. denied*, 369 U.S. 882 (1962), and reinstated a jury verdict, stating that "the provisions of the Seventh Amendment ... are brought into play." In the course of the opinion, the litigants were reminded of the constitutional mandate:

> We might agree with the Court of Appeals had the questions of fact been left to us. But neither we nor the Court of Appeals can redetermine facts found by the jury any more than the District Court can predetermine them. For the Seventh Amendment says that "no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than

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cluded that a pro-patent bias on infringment issues was "not clear." Janis, 2001 U.Ill.L. Rev. at 400-01 and n. 64.

according to the rules of the common law."

369 U.S. at 358-59. Here, as there, the judicial intrusion into the fact-finding process was so great as to implicate the Seventh Amendment and violate Petitioners' constitutional right to a jury trial.

5. The Federal Circuit's failure to defer to the jury was exacerbated by the procedural posture of this case. Powerscreen's only pre-verdict motions pertained solely to Read's inducement claim (A000106-15, A000182-200). Powerscreen never asserted that the evidence was insufficient to support a verdict of infringement under the doctrine of equivalents.

The power of a federal judge to enter judgment as a matter of law ("JMOL") upon motion of the verdict-loser is set down in Fed.R.Civ.P. 50 and is circumscribed by the Seventh Amendment. That power is predicated upon the filing of a pre-verdict motion for JMOL that "specif[ies] the judgment sought and the law and the facts on which the moving party is entitled to judgment." Fed. R. Civ. P. 50, Advisory Committee Notes to 1991 Amendment provides:

> Paragraph (a)(2) retains the requirement that a motion for judgment be made prior to the close of the trial, subject to renewal after a jury verdict has been rendered. The purpose of this requirement is to assure the responding party an opportunity to cure any deficiency in that party's proof that may have been overlooked until called to the party's attention by a late motion for judgment. ... The second sentence of paragraph (a)(2) does impose a requirement that the moving party articulate the basis on which a judgment as a matter of law might be rendered. The articulation is necessary to achieve the purpose of the requirement that the motion be made before the case is submitted to the jury, so that the responding party

> may seek to correct any overlooked deficiencies in the proof.

According to the Advisory Committee Notes, Subsection (b) "retains the concept of the former rule that the post-verdict motion is a renewal of an earlier motion made at the close of the evidence." Two reasons are given:

> One purpose of this concept was to avoid any question arising under the Seventh Amendment. *Montgomery Ward & Co.* v. *Duncan*, 311 U.S. 243 (1940). It remains useful as a means of defining the appropriate issue posed by the post-verdict motion. A post-trial motion for judgment can be granted only on grounds advanced in the pre-verdict motion.

In decisions prior to the case at bar, the Federal Circuit recognized the importance of a pre-verdict motion on the precise issue raised by the post-verdict motion. Citing this Court's decision in *Cone* v. *West Virginia Pulp & Paper Co.*, 330 U.S. 212 (1947), it stated that "[p]roviding the opportunity to the nonmovant to repair gaps in its proofs is the reason Rule 50(b) is rigorously applied." *Hoechst Celanese Corp.* v. *BP Chemicals Ltd.*, 78 F.3d 1575, 1582 (Fed. Cir.), *cert. denied*, 519 U.S. 911 (1996).

In *Hoechst*, the Federal Circuit held that a motion and memorandum focusing "entirely on the meaning of 'stable,'" which made "no mention of the doctrine of equivalents," did not preserve an argument under the doctrine of equivalents. *Id.* In other cases, the Federal Circuit held that a pre-verdict motion on infringement, inducement, and contributory infringement did not preserve a claim that the party did not infringe pursuant to 35 U.S.C. § 271(f) by supplying components (*Southwest Software, Inc.* v. *Harlequin Inc.*, 226 F.3d 1280, 1288 (Fed. Cir. 2000) and suggested that a pre-verdict motion on infringement would not preserve willful infringement

(*Orthokinetics, Inc.* v. *Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1579-80 (Fed. Cir. 1986)). Although, here, the Federal Circuit majority relied upon boilerplate language in the heading, introduction, and conclusion to Powerscreen's pre-trial motion, in previous cases it rejected arguments that broad references to "invalidity defenses" and "all issues" were sufficient. *Kinzenbaw* v. *Deere & Co.*, 741 F.2d 383, 387-88 (Fed. Cir. 1984), *cert. denied*, 470 U.S. 1004 (1985); *Snellman* v. *Ricoh Co.*, 836 F.2d 528, 532 (Fed. Cir. 1987).[14]

The Rule 50 decision in this case deprived Read of the opportunity to repair gaps in its evidence, as envisioned by the framers of Rule 50. Had Powerscreen revealed its argument, Read could have sought to recall Professor Slocum. The trial judge would have had the opportunity to comment on the evidence which Powerscreen successfully challenged and the Federal Circuit majority has now parsed. Read was ambushed when Powerscreen was permitted to convert a JMOL motion on inducement to infringe, predicated on the absence of evidence which pertained to a period beginning in 1997, into one of direct infringement concerning structures that were proven to exist as early as 1990.

6. The Federal Circuit departed not only from its own precedent but also departed from its own choice of

[14] The Federal Circuit majority did not distinguish *Hoechst* and *Southwest*, both of which were cited in Read's brief, nor did it grant rehearing when additional cases were brought to its attention (A-2-3). The precedent upon which the majority relied was inapposite (see A-3.). In *Malta* v. *Schulmerich Carillons Inc.*, 952 F.2d 1320, 1324-25 (Fed. Cir. 1991), *reh. denied*, 959 F.2d 923, *cert. denied*, 504 U.S. 974 (1992), the movant made only barebones oral motions. Since no details were given, the plaintiff was not misled. The conclusory footnote in *Texas Instruments Inc.* v. *Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566, n.6 (Fed. Cir. 1996), *cert. denied*, 520 U.S. 1228 (1997), does not expand on *Malta*.

law rules. The majority conceded that the Federal Circuit normally looks to the law of the regional circuit in determining the effect of a failure to make a pre-verdict motion (A-3, n.1). Here, it relied upon a corollary to that rule under which it applies its own law to procedural decisions when the issue "relates particularly to patent law." *Id.* None of the cases it cites for this choice of law rule includes a choice of law analysis. *Hoechst*, which deals with as patent-laden a JMOL motion as the one at bar, relies solely upon regional circuit law. 78 F.3d at 1581-82.

The First Circuit, the regional circuit, here, strictly applies the requirement that a ground for judgment not "distinctly articulated" in a pre-verdict JMOL motion is waived. *Correa, supra*, 69 F.3d at 1196. Had First Circuit law been followed, Powerscreen would not have been permitted to attack the verdict finding infringement under the doctrine of equivalents in this appeal.

Litigants before the Federal Circuit are left in a quandary regarding this choice of law issue. While *Hoechst* is a precedential decision and the case at bar is not, other litigants may well rely upon cases such as *Hoechst*, which employ regional circuit law, only to find that the Federal Circuit has chosen its own law. If, as here, Federal Circuit law permits a post-verdict argument to hinge upon boilerplate language in an otherwise focused pre-verdict motion, then Federal Circuit law conflicts with the spirit, if not the letter, of Rule 50. By severing the connection between pre-verdict and post-verdict motions, it also impinges upon Seventh Amendment rights. See Advisory Committee Notes, *supra, citing, Montgomery Ward, supra.*

7. While this Court has upheld the right of a court of appeals to order entry of judgment, rather than to order a new trial or remand to the trial court, it has cautioned that this power should be used sparingly. This Court

stated in *Neely* v. *Martin K. Eby Construction Co.*, 386 U.S. 317, 325, *reh. denied*, 386 U.S. 1027 (1967), and reaffirmed in *Weisgram v. Marley Co.*, 528 U.S. 440, 450-51 (2000):

> Part of the Court's concern has been to protect the rights of the party whose jury verdict has been set aside on appeal and who may have valid grounds for a new trial, some or all of which should be passed upon by the district court, rather than the court of appeals, because of the trial judge's first-hand knowledge of witnesses, testimony, and issues—because of his "feel" for the overall case. These are very valid concerns to which the court of appeals should be constantly alert.

The discussion in *Weisgram* regarding the respective rights of parties when a jury verdict is overturned on appeal was predicated on the assumption that "the party whose verdict is set aside on appeal will have notice, before the close of evidence, of the alleged evidentiary deficiency." 528 U.S. at 454. In *Weisgram*, where the verdict winner "was on notice every step of the way" and "offered no specific grounds for a new trial," entry of judgment was affirmed. *Id.* at 456. On the other hand, this Court's opinions "make it clear that an appellate court may not order judgment n.o.v. where the verdict loser has failed strictly to comply with the procedural requirements of Rule 5[0](b), or where the record reveals a new trial issue which has not been resolved." *Neely*, *supra*, 386 U.S. at 325.

In the case at bar, even the Federal Circuit majority concedes that Powerscreen's pre-verdict motion "argued that there was no evidence" of inducement and that any other assertions were made "[i]n the introduction, in a section heading, and in the conclusion to its motion" and

were made "without elaboration" (A-2-3). There was no strict compliance with Rule 50. The Federal Circuit never explicitly considered the issue of whether to remand for a new trial or to give the trial judge the opportunity to make such a determination (A-15). Read argued in its rehearing petition that it would have sought to recall Professor Slocum to the stand had it been apprised of Powerscreen's argument at the close of the evidence. While the Federal Circuit had the power to order entry of judgment for Powerscreen, that power should not have been exercised. Instead, even if the Federal Circuit were correct on the waiver and evidentiary issues, it should have heeded this Court's cautions and either ordered a new trial itself or remanded so that the district court judge, who had the "feel" of the case, could have made the determination.

8. For the foregoing reasons, this petition for a writ of certiorari to the United States Court of Appeals for the Federal Circuit should be granted.

Respectfully submitted,

Jack R. Pirozzolo
Counsel of Record for Petitioners
Judith S. Ziss
Richard L. Binder
Willcox, Pirozzolo & McCarthy
Professional Corporation
50 Federal Street
Boston, Massachusetts 02110
(617) 482-5470

Note: Pursuant to Fed. Cir. R.47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

No. 01-1453, 01-1454.

THE READ CORPORATION, F.T. READ & SONS, INC., AND NORDBERG-READ, INC.,
Plaintiffs-Cross Appellants,
v.
POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD., AND POWERSCREEN INTERNATIONAL, PLC,
Defendants-Appellants.

DECIDED: August 7, 2002.

Before CLEVENGER, BRYSON, and PROST, Circuit Judges.
Opinion for the court filed by *Circuit Judge* BRYSON.
Dissenting opinion filed by *Circuit Judge* PROST.

BRYSON, *Circuit Judge*.

Powerscreen of America, Inc., Powerscreen International Distribution, Ltd., and Powerscreen International, PLC ("Powerscreen") appeal the judgment of the United States District Court for the District of Massachusetts, finding Powerscreen liable for infringement of U.S. Patent No. 4,237,000 ("the '000 patent") and awarding enhanced damages and attorney fees to plaintiffs Read Corp., F.T. Read & Sons, Inc., and Nordberg-Read, Inc. ("Read"). Read cross-appeals the district court's judgment that Powerscreen did not infringe U.S. Patent No. 4,256,572 ("the '572 patent"). We *affirm in part* and *reverse in part*.

I

Before the trial court, the parties focused on whether the centerplate structure of Powerscreen's portable earth-sifting device, the Powergrid, infringed claim 1 of the '000 patent and whether the front jacking legs of the Powergrid infringed claim 1 of the '572 patent. The jury returned a verdict that the Powergrid did not infringe the '572 patent and did not literally infringe the '000 patent, but that the Powergrid infringed the '000 patent under the doctrine of equivalents and Powerscreen induced others to infringe that patent. The jury found that Powerscreen's infringement was willful and awarded damages of $14,483,320 to Read. The trial court denied Powerscreen's motion for JMOL or a new trial, doubled the jury's damages award pursuant to 35 U.S.C. § 284, awarded attorney fees under 35 U.S.C. § 285, and added prejudgment interest. The court also denied Read's motion for JMOL with respect to the jury's verdict of non-infringement of the '572 patent. The court entered judgment for Read in the amount of $34,921,739.09. Both parties appeal the district court's denial of their respective motions for JMOL.

II

Before reaching the merits, we first address a procedural issue raised by Read. Read asserts that Powerscreen waived its challenge to the sufficiency of the evidence of the jury's verdict of infringement under the doctrine of equivalents because Powerscreen failed to raise that issue with sufficient specificity in its pre-verdict Rule 50(a) motion for JMOL. The district court ruled that Powerscreen did not waive the issue, and we agree.

The primary focus of Powerscreen's Rule 50(a) motion with respect to the '000 patent was that Read failed to present evidence of the direct infringement that is necessary to support a finding of inducement. In particular, Powerscreen argued that there was no evidence that users of the Powergrid infringed the '000 patent by

installing a bolted connecting plate between the two screens of the Powergrid shaker assembly. In the introduction, in a section heading, and in the conclusion of its motion, however, Powerscreen broadly asserted that the evidence did not support a finding that Powerscreen infringed the '000 patent. Those assertions, although presented without elaboration, were sufficient to preserve Powerscreen's legal challenge to the sufficiency of the evidence with respect to infringement, including infringement under the doctrine of equivalents. *See Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1324-25, 21 USPQ2d 1161, 1164 (Fed.Cir.1991) (holding that a barebones motion for directed verdict on the issue of noninfringement was adequate to support a post-verdict JNOV motion concerning the doctrine of equivalents); *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566 n. 6, 39 USPQ2d 1492, 1498-99 n. 6 (Fed.Cir.1996) (same).[1]

III

A

On the merits, we review the district court's denial of the parties' respective motions for JMOL without deference. See *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed.Cir.1998) (en banc).

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[1]In determining the effect of a party's failure to move for JMOL, this court looks to the law of the applicable regional circuit. *See Delta-X Corp. v. Baker Hughes Prod. Tools, Inc.*, 984 F.2d 410, 412, 25 USPQ2d 1447, 1449 (Fed.Cir.1993). This case, however, involves not the general question of the effect of a failure to move for JMOL, but the specific question whether a JMOL motion directed to patent infringement is sufficient to preserve the party's appellate rights to contest a verdict of infringement under the doctrine of equivalents. That issue, which relates particularly to patent law, has been treated as a matter governed by this court's law. *See Texas Instruments*, 90 F.3d at 1566 n. 6, 39 USPQ2d at 1498-99 n. 6; *Malta*, 952 F.2d at 1324-25, 21 USPQ2d at 1164; cf. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1579, 1 USPQ2d 1081, 1091 (Fed.Cir.1986)

We review the jury's resolution of all factual disputes for substantial evidence. *Id.* "Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938). In performing that task, we must consider all the evidence in the light most favorable to the Read, the nonmoving party, without weighing the credibility of witnesses and without substituting our judgment for that of the jury in deciding factual issues on which there is conflicting evidence. *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 859, 20 USPQ2d 1252, 1259 (Fed.Cir.1991)

B

To establish infringement under the doctrine of equivalents, Read was required to show that the accused Powergrid device contains elements that are identical or equivalent to each limitation recited in claim 1 of the '000 patent. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 (1997). An element of an accused device is equivalent to a limitation of the claimed invention if the differences between them are insubstantial or if each element of the accused device performs substantially the same function in substantially the same way to obtain the substantially the same result as the corresponding limitation of the asserted claim. *Id.*

In arguing that the evidence was sufficient to support the jury's finding of infringement under the doctrine of equivalents, Read relies principally on the testimony of two witnesses, Alexander Slocum and Neill Suitor. After carefully reviewing the testimony of those two witnesses, we conclude that Read failed to elicit the evidence necessary to support the jury's finding of infringement under

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(holding that infringement and willful infringement are not the same, and that a motion for a directed verdict of noninfringement did not encompass willful infringement).

the doctrine of equivalents.

Read introduced its inducement case through its expert, Mr. Slocum, who testified extensively as to the disadvantages of the Powergrid's centerplate structure. Specifically, he testified that Powergrid's dual centerplate structure allowed displacement between the screen decks, which resulted in cracking problems in the Powergrid shaker assembly. Accordingly, he advanced the theory that in 1997 Powerscreen introduced its "bolt hole" design to induce users to overcome the displacement between the Powergrid screen decks by bolting a connecting plate that joined the centerplates of each deck. Mr. Slocum articulated that theory as follows:

> How would I reduce the deflection? The logical thing is when you see this large breathing mode [the movement of the centerplates and front crossbeams in opposite directions] is to pin it. The way I would stop the displacement between the upper and lower decks from happening to make the machine behave like we want to there is I would put a connection between the ends.

Mr. Slocum's theory was that the Powerscreen drilled bolt holes at the front ends of Powergrid centerplates in 1997 in order to induce users to install connecting plates (or "side plates") to join the ends of the upper and lower screen decks and thus solve the cracking problem.

The record makes clear that most of Mr. Slocum's testimony was directed to supporting Read's inducement theory, rather than showing equivalence. Evidence on the doctrine of equivalents, however, cannot merely be "subsumed" in Read's inducement case, *Lear Siegler, Inc. v. Sealy Mattress Co.*, 873 F.2d 1422, 1425, 10 USPQ2d 1767, 1770 (Fed.Cir.1989); rather, Read was required to offer particularized testimony and argument in support of its theory of equivalence on a limitation-by-limitation basis, *see Texas Instruments*, 90 F.3d at 1567, 39 USPQ2d at 1499. The only portion of Mr. Slocum's testimony that

relates to the doctrine of equivalents is the following colloquy on his redirect examination:

> Q: Does the structure perform the function of that element [the "rigid longitudinal center plate"] of the claim?
>
> A: It inefficiently performed the function.
>
> Q: And what was the way in which it performed that function?
>
> A: The way in which it performed it was it actually had portions of metal that connected, physically, part of the top center plate to the bottom centerplate, and that it also had the capability to very efficiently, almost 100 percent, couple it, should the side bolts be added back on to where they apparently were before.
>
> Q: And what was the result of that structure?
>
> A: Well, the way I saw the machine, without the side plates on, the machine clearly functioned. They sold it. It vibrates, it shakes. The warranty discussions I had read as part of my background for this had said there was cracking. And when I also saw the paint that had been imprinted by side plates bolted on after the machine had been built, told me that someone said this is a problem and let's make it a more efficient coupling by bolting on those plates.

We find no fault in Read's reliance on the "function-way-result" test, because that test is particularly suitable for analyzing mechanical devices such as the claimed shaker assembly. *See Warner-Jenkinson*, 520 U.S. at 39. We conclude, however, that Mr. Slocum's testimony on function, way, and result did not provide an adequate evidentiary basis to support the jury's finding of infringement.

With respect to "function," Mr. Slocum testified that the accused structure "inefficiently performed the function" of the claimed centerplate. That is, he testified that the centerplates of the Powergrid performed the function of the claimed centerplate but that they did so poorly, which undermines rather than supports a finding of

equivalence.

As to "way," Mr. Slocum's testimony was wholly deficient. He did not compare the accused structure to the claim or offer any explanation as to whether or how it would perform in substantially the same way as the claimed invention in the absence of connecting plates installed at the front end of the centerplates. *See Texas Instruments*, 90 F.3d at 1568, 39 USPQ2d at 1500 (expert testimony delivered in "conclusive fashion" was insufficient because "there was no discussion of whether or how the way the [element of the accused device] operates was similar to the patent claim, nor was there any particularized testimony explaining why the function and result were the same").

Finally, as to "result," Mr. Slocum's statement that the Powergrid achieved the same result as the claimed invention because "they sold it" is clearly directed to the screening device as a whole and not to the claim limitation of the rigid longitudinal centerplate that is disputed in this appeal. Testimony that the Powergrid as a whole performed the same function as the claimed shaker assembly cannot support a finding of equivalence. "[G]eneralized testimony as to overall similarity" between the claims and the accused infringer's product or process "cannot support a finding that the differences are 'insubstantial.' " *Id.*

The purpose of requiring particularized testimony with respect to equivalence is to ensure that the jury is provided with the proper evidentiary foundation from which it can conclude that a disputed claim limitation has been met by an equivalent. *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1188, 48 USPQ2d 1001, 1006 (Fed.Cir.1998). Mr. Slocum's testimony does not provide such a necessary foundation. If anything, the import of Mr. Slocum's testimony is that without a connecting plate the accused device was substantially inferior to the device recited in

the patent. That is not evidence of equivalence but evidence of nonequivalence.

Read also directs us to the testimony of Powerscreen's expert witness, Mr. Suitor. Although Mr. Suitor did not testify at trial, portions of his deposition testimony were read to the jury. Read argues that Mr. Suitor "admitted" that the Powergrid centerplates were equivalent to the "rigid longitudinal centerplate" claimed in the '000 patent. We disagree and instead conclude that Mr. Suitor's testimony, like Mr. Slocum's, is insufficient to support the jury's conclusion that Powerscreen infringed under the doctrine of equivalents.

Much of Mr. Suitor's testimony was directed to a comparison between two different Powergrid centerplate designs. The first design, built for the U.S. market, is the two-centerplate device accused of infringement in this case. The second design, built for the European market, consisted of a single centerplate. Powerscreen admits that the European-style single centerplate design would have literally infringed if it had been deployed in the U.S. market. Read cites the following excerpts from Mr. Suitor's testimony:

> Q: Why is that plate [the centerplate of the U.S. version of the Powergrid][2] included in the screen box at all?
>
> A: It's used to connect the cross beams which run transversely to each other.
>
> Q: Does it strengthen the screen?
>
> A: Yes.
>
> Q: How does it strengthen the screen box?

---

[2] On the face of the record, it would appear that this testimony refers to Suitor Exhibit 2, which corresponds to European single centerplate design. *See* J.A. at 101192, ln.19, 101594, ln.17 ("Does the center plate of Suitor *2* achieve substantially the same function?") (emphasis added). The parties have clarified,

A: It rigidly connects the cross beams on each deck and transmits the force from one to the other and into the back plate.

Contrary to Read's contention, Mr. Suitor's testimony does not constitute an admission that the accused U.S. centerplate design satisfies the claim requirement that the invention "join[s] the upper and lower levels of structural crossbeams such that forces applied to the screen assembly are transmitted through the centerplate to the joined cross beams." Rather, his testimony states only that the U.S. centerplate design connects the crossbeams within each level; that is, one centerplate connects the upper crossbeams and the other centerplate connects the lower crossbeams. The dissent argues that Mr. Suitor's testimony could be interpreted to mean that the centerplates transmit the forces "from one [deck] to the other [deck] and into the back plate." That interpretation, which requires insertion of the critical terms, is contrary to Mr. Suitor's words. He made quite clear that each centerplate connected the cross beams "on each deck," i.e., that each centerplate simply transmitted force from one cross beam to another within the same deck. Mr. Suitor's testimony is silent as to whether, and to what extent, forces on the crossbeams of each deck were transmitted through the back plate and to the crossbeams of the other deck. The cited testimony therefore does not constitute evidence that the centerplates in the accused device transmit forces between the two decks.

Mr. Suitor next testified as follows regarding the accused U.S. Powergrid and its European counterpart:

Q: Do the screens that are built in accordance with Suitor Exhibit 1 [the U.S. design] perform any differently to the screens built in accordance with Suitor

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however, that there is a typographical error on the record, and that this testimony actually refers to Suitor Exhibit 1, which corresponds to the U.S. centerplate design.

Exhibit 2 [the European design]?
A: No.
Q: You say no?
A: No.
Q: Do they perform substantially the same way?
A: Yes.
....
Q: And do both those screens screen material?
A: Yes.
Q: Do they achieve substantially the same result?
A: Yes.

It is clear that both the questions posed by counsel and Mr. Suitor's responses are directed solely to a comparison of the reliability and performance of the large and small mesh screens of the U.S. and European Powergrid models, not to a comparison of the two different centerplate designs. It cannot be interpreted as an admission that the U.S. Powergrid centerplates infringe the '000 patent under the doctrine of equivalents. In fact, two transcript pages earlier, Mr. Suitor expressly testified that the U.S. centerplates did *not* achieve substantially the same function as their European counterpart:

Q: What is the function of Exhibit 2 [the European centerplate]?
A: That is the center division plate that joins [the] top and bottom deck together on the Powergrid screen box.
Q: And what was the result achieved by that?
A: There is a slight improvement in the structure, structure integrity.
Q: And what is the way in which that improvement is achieved?
A: By making the connection towards the front of the screen box it causes two parts to be rigidly connected.
Q: Does the center plate of [the U.S. design] achieve substantially the same function?
A: No.

Q: Because—and why do you say that?

A: Because there is no connection at the front part of the screen box.

That testimony is consistent with other portions of Mr. Suitor's testimony to the effect that the U.S. and European centerplate designs were in fact, very different:

Q: So now I'm confused. Prior to 1990?

A: There was one design.

Q: One design was what?

A: It has two individual centre plates.

Q: One bracing the top members to each other, cross members, and the other bracing the bottom cross members to each other?

A: Correct.

Q: Post 1990 what was the configuration of the centre bracing member method?

A: Post 1990 we have two designs which run concurrently. One is as discussed before, continue [sic] unchanged and we have a second design which essentially joins the top and bottom deck together by adding a piece of material in the gap between the upper and bottom bracing plates to finish up with one large plate it [sic] covers both sets of cross members.

Q: Now why do you have a design—for what purpose do you have a design for bracing member that attaches the top cross members to the bottom cross members?

A: Because it is structurally superior.

Q: And what makes it structurally superior?

A: The vibration between the top deck and the bottom deck is in a different phase or a different style of vibration and the net result is that you have only about half of the problematic or out of phase vibration experienced between the two crossbeams and surrounding structure. In fact what it does is it reduces the problem by 50 percent.

Given the extent to which Mr. Suitor testified as to the differences between the U.S. and European centerplates, it would be unreasonable to infer that his "function-way-result" testimony was directed to a comparison of those centerplates, rather than to a comparison of the mesh screens on the U.S. and European devices. Like Mr. Slocum's testimony, then, Mr. Suitor's testimony does not provide sufficient evidence for a jury to determine that the Powergrid centerplates are equivalent to the claimed "rigid, longitudinal center plate."

Because we conclude that the evidence was not sufficient to support the jury's finding that Powerscreen infringed the '000 patent under the doctrine of equivalents, we hold that Powerscreen is entitled to judgment as a matter of law on that issue. For that reason, it is unnecessary for us to address Powerscreen's argument that a finding of equivalence in this case is precluded as a matter of law because it would vitiate the claim limitation requiring that the longitudinal centerplate be "rigid." *See Warner-Jenkinson*, 520 U.S. at 29 ("It is important to ensure that application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.").

C

Read's theory of infringement under the doctrine of equivalents was directed to all 508 Powergrid devices sold in the United States between 1990 and early 1999, and the jury's verdict was based on finding infringement with respect to all of those devices. Read offered a second theory of liability at trial, that Powerscreen placed bolt holes in its Powergrid design to induce customers to install connecting plates between the two screen decks. That theory of induced infringement applied only to those devices sold in the United States after 1997, when Powerscreen introduced the bolt-hole design.

A finding that a claim is infringed is a necessary pre-

requisite to a finding that there has been an act constituting inducement to infringe under 35 U.S.C. § 271(b). *Zenith Labs., Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1423 n. 5, 30 USPQ2d 1285, 1289 n. 5 (Fed.Cir.1994). Therefore, to sustain the jury's finding of inducement, Read was required to offer evidence sufficient to show that someone in the United States actually inserted the connecting plate so as to constitute direct infringement (either literal or by equivalence) of claim 1 of the '000 patent. Based on the trial record, it is clear that no reasonable jury could have found an underlying act of direct infringement.

Read's witnesses, Mr. Read and Mr. Slocum, both admitted that they had never seen a Powergrid with connecting plates in the United States. No other witness testified that even a single Powergrid machine in the United States had connecting plates. The only evidence of direct infringement cited by Read was the testimony of Mr. Slocum, who inspected a Powergrid in Louisville, Kentucky in 1999 and observed a paint pattern on its centerplates that suggested that a connecting plate had once been installed on the machine. Mr. Read offered similar testimony concerning a Powergrid he inspected in Chelmsford, Massachusetts. Powerscreen does not dispute that the connecting plates were installed on Powergrid machines during their manufacture in Northern Ireland. The evidence was that those connecting plates remained on the units that were shipped to Europe, but were removed from the units destined for the United States, allowing Powerscreen to have a single screen box that it could manufacture for anywhere in the world, but which it could convert for the American market if necessary. In light of that evidence regarding the reason for the bolt holes, there is no basis in the record for inferring that an act of direct infringement occurred in the United States.

The dissent suggests that many of Powerscreen's cus-

tomers may have installed the connecting plates, but there is no probative evidence to support that contention. Read produced no direct evidence that even a single machine had been modified in that manner in the United States; the only evidence that Read could muster in support of its inducement theory was the paint mark evidence suggesting that a connecting plate once had been attached to two Powergrid devices. In light of the evidence that the connecting plates were placed on the machines during manufacture overseas but removed prior to their importation into the United States, the "paint marks" evidence is insufficient as proof of even a single act of infringement in the United States.

The dissent discusses Mr. Slocum's testimony that the Powergrid devices would have a tendency to crack without the inclusion of the connecting plates, as well as the fact that of the more than 500 devices sold in the United States, fewer than 10 customers submitted warranty claims based on cracking. The dissent relies on those two pieces of evidence to support the inference that most, if not all, of Powerscreen's customers installed the connecting plate. Because Powerscreen did not introduce the "bolt hole" design until late in 1997, the warranty claim evidence cannot support a finding of inducement with respect to any Powergrid devices manufactured prior to 1997. Furthermore, as to those devices manufactured after 1997, the inference that the dissent draws from the small number of warranty claims is unconvincing. At the same time that Powerscreen introduced the bolt holes in 1997, it also strengthened the screen box by introducing a substantially stronger front cross member into its Powergrid design. Mr. Suitor's testimony suggests that this single design change solved the cracking problem and did so in a different way by cutting the vibration of the screen box in half, bringing it down to the same level of vibration as that found in the pre-1997 European design with the single, solid centerplate. The

absence of warranty claims would not in any event serve as a basis for inferring that those customers who did not submit warranty claims installed connecting plates on their Powergrid machines, but the inference is even weaker in light of the different measures that Powerscreen took to address the cracking problem.

We thus conclude that Read did not present substantial evidence to support the jury's finding that Powerscreen induced others to infringe the '000 patent, and we therefore hold that Powerscreen is entitled to judgment on that issue as a matter of law.

D

Because Powerscreen is entitled to judgment as a matter of law with respect to infringement under the doctrine of equivalents and inducement, we reverse the award of damages and attorney fees. We do not address Powerscreen's arguments regarding laches and the statutory limitation on damages under 35 U.S.C. § 286.

IV

Read cross-appeals from the district court's denial of its motion for JMOL that Powerscreen infringed the '572 patent. According to Read, the district court's jury instruction with respect to the "moveable wheels" limitation in the asserted claims of the '572 patent compelled a verdict of infringement.

U.S. Patent No. 4,197,194 ("the '194 patent"), which is the parent of the '572 patent, shares the same "moveable wheels" limitation that is at issue in this case. In *Read Corp. v. Portec Inc.*, 970 F.2d 816, 23 USPQ2d 1426 (Fed.Cir.1992), this court upheld a jury's finding of infringement of the '194 patent because there was substantial evidence that the retractable footpad in Portec's accused device was equivalent to the same "movable wheels" limitation that is disputed in this case. In the course of holding that the claim language permitted such a finding of equivalence, this court stated:

Read's moveable wheels allow for the heavy weight of

> the loaded machine to be taken off the wheels and provide for stability of the machine during screening operations by placing the frame "flush on the ground." ... The claim does not exclude some weight remaining on the wheels.

Portec, 970 F.2d at 823-24, 23 USPQ2d at 1433. In accordance with this court's holding in *Portec*, the district court instructed the jury that in order to find equivalence, the claim "does not require that all the weight be taken off the wheels. It's enough that the bulk of the weight be shifted from the wheels."

At trial, Read presented undisputed evidence that, while transitioning the Powergrid from transport to operating position, a large amount of weight is transferred off the fixed wheels and onto the front jacking legs. Specifically, Read's weight measurements indicated that the Powergrid weighs a total of 34,480 pounds, that the Powergrid's fixed wheels bear 20,440 pounds of weight in transport mode, and that they bear 14,220 pounds of weight in screening mode. Under the district court's jury instruction, Read argues that the evidence regarding the transfer of weight required the jury to return a verdict of infringement. We disagree.

We read this court's statements in *Portec* and the trial court's jury instructions as establishing that the jury was permitted, but not required, to find equivalence in the event that it concluded that the "bulk of the weight" was shifted off the fixed wheels of the Powergrid. Even in the absence of contrary evidence, the jury was free to conclude that the transfer of 6,220 pounds out of a total of 20,440 pounds of weight from the wheels did not constitute the "bulk of the weight." Thus, the jury could permissibly find that the Powergrid's fixed wheels and jacking legs were more than insubstantially different from the "moveable wheels" limitation claimed in the '572 patent, and the district court properly denied Read's motion for JMOL with respect to that patent.

Because the jury was permitted to conclude that the Powergrid did not infringe the '572 patent under the doctrine of equivalents, it is unnecessary for us to consider whether the prosecution history of the '572 patent and the '194 patent would preclude any finding of equivalence as a matter of law under the Supreme Court's recent decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831 (2002).

PROST, *Circuit Judge*, dissenting.

I respectfully dissent. After a fifteen-day trial where the parties presented the testimony of thirteen witnesses and introduced dozens of exhibits into evidence, a unanimous jury found that Powerscreen induced infringement of the '000 patent and that the Powergrid device infringed under the doctrine of equivalents. The presiding Chief Judge, having also observed all the trial evidence and considered additional briefing and arguments of counsel, denied Powerscreen's motion to overturn the jury's verdict. According to the district court, "If the doctrine of equivalents has any remaining vitality, this is a case where the doctrine of equivalents is appropriately applied." I agree.

"It is not the province of an appellate court to second guess the jury's credibility determinations or to reevaluate the weight to be given to the evidence." *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1192, 48 USPQ2d 1001, 1009 (Fed.Cir.1998). Our job is to determine whether there is substantial evidence from which the jury could find infringement by a preponderance of the evidence standard, in light of *all* the evidence presented at trial, as well as reasonable inferences therefrom. *Id.* "Upon full trial, upon agreed and correct jury instructions, upon substantial evidence in the form of testimony and exhibits and demonstrations, a reasonable jury could have reached the verdict of infringement. That ends our review." *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1331, 21 USPQ2d 1161, 1170 (Fed.Cir.1992) (Newman, dissenting). With all due respect to the majority, I understand the evidence as clearly supporting the jury's verdict in this case, particularly when issues of credibility and all reasonable inferences from the evidence are resolved in Read's favor.

The jury's verdict can be most readily understood by starting with the evidence supporting inducement to infringe, because once the jury's finding of inducement is

accepted, it is easy to see how the jury then found infringement under the doctrine of equivalents. As discussed below, my view of the evidence is that the Powerscreen device, once modified by customers who were so induced to make the relevant modification, is insubstantially different from the claimed center plate.

I. Inducement to Infringe

Only one limitation of the claimed shaker assembly is at issue in this case: the "at least one rigid longitudinal center plate generally parallel to and between the side plates and joining the upper and lower levels of structural cross beams such that forces applied to the screen assembly are transmitted through the center plate to the joined cross beams." '000 Patent, col. 5, l. 6—col. 6, l. 2. The Powergrid shaker accused of infringement includes two center plates: an upper plate that joins the structural cross beams of an upper screen, and a lower center plate that joins the structural cross beams of a lower screen. Each center plate is welded to the back side of the screen box, and a gusset runs between the plates where they connect to the back of the screen box. Each of the center plates is drilled with five bolt holes at their front ends.

One of Read's theories at trial was that Powerscreen induced customers to infringe claim 1 of the '000 patent by bolting an additional plate into these holes, thereby connecting the upper and lower center plates of the screen box at their front ends. Read's evidence included engineering diagrams of the upper and lower center plates showing the bolt holes, as well as a diagram of the plate that could be used to connect the upper and lower center plates using the bolt holes. According to Mr. Read, it would be trivial for a customer to add the connecting plate. "It would be about $40 for material and couple hours of labor, and it wouldn't take that much to do."

In addition, Powerscreen arranged for Mr. Read, Read's expert Professor Slocum, and a special master

appointed by the court to inspect a representative Powergrid device located in Kentucky. The expert took a series of photographs of the device, which he discussed during his testimony and were admitted into evidence. These photographs show the upper and lower center plate structure of the Powergrid device—with bolt holes but without a connecting plate. Read's expert testified that at some point in time, the device had been modified to include the connecting plate. Pointing to one of the photographs of the device, he showed the jury where "you can see the mark, painting mark where the plate has been bolted in the past."

Notably, Powerscreen presented no witness to deny that the representative Powerscreen device once had a connecting plate. Nor did Powerscreen present a witness to deny that customers in general add these connecting plates. Rather, Powerscreen relies on Mr. Read's and Mr. Slocum's admissions that they never actually observed a machine in the United States with the connecting plate installed. In response to this admission, Professor Slocum testified as follows on redirect:

> Q. Okay. And did you—in your opinion, are the bolt holes there for the purpose of manufacturing the machine? ... What do you think they're there for?
>
> THE WITNESS: Well, I've designed a lot of big iron, which is what this is called. The only reason I could possibly fathom why those holes are there for manufacturing purposes is to manufacture the upper and lower deck so they are aligned perfectly so you could later easily add the plate.
>
> If there was no design intent to ever have a plate afterwards, you would never, ever spend the money to put the holes in there.

The only other evidence on this issue presented by Powerscreen was the following excerpt from the deposition transcript of Mr. Suitor, a Powerscreen engineer: "Machines *going* to the US of A have no center plate"

(emphasis added). While this statement may or may not be true (the jury was free to believe or disbelieve Mr. Suitor), this denial says nothing about what customers in the United States do once the machines are here.

In fact, warranty evidence shows that customers do indeed install the connecting plate. According to Professor Slocum, when a device does not have the connecting plate installed, the upper and lower screen decks are

> inefficiently coupled together, so they're only welded a little bit at the back, to—which created a condition, I believe that the warranty reports called for, where there was cracking and they had to fix the cracking, to where you bolt a plate into the front through the bolt holes that are provided in the upper and lower middle plates, again, you increase the stiffness or you decrease the deflections by a factor of five to ten. And, therefore, you'll get rid of your cracking problems.

In other words, if customers did *not* install the connecting plate, their machines would crack apart. Yet of the over 500 devices sold in the United States, fewer than 10 customers submitted warranty claims based on cracking. The logical inference from this evidence is that most, if not all, of Powerscreen's customers installed the connecting plates.

Read's counsel summarized the import of all this evidence during his closing argument:

> [T]here's evidence that the plate was in the machines in America. You will see the outline of the plate in this photograph that's projected. You see the red, it's been there.... And knowing Mr. Read was going to come in and see it, [Powerscreen] took it [the connecting plate] off for the inspection, got a little careless. So they see there's no plate. But there is clear evidence that in this region here, and this region here, there was no paint, which means the plate was there and had been taken off. They knew Mr. Read was going to see it.

Based on my review of the record and the parties' arguments on appeal, I understand the jury to have found that customers in the United States have indeed modified Powerscreen's devices by adding the connecting plate using the existing bolt holes, an obvious and easy modification. The district court apparently shares my understanding of the evidence, stating that "there may be infringement by the doctrine of equivalents by bolting those things [the upper and lower plates] together, if anyone was doing that. But I think they can infer that people were."

In my opinion, the jury's verdict of inducement to infringe is supported by substantial evidence, including reasonable inferences that can be drawn from the evidence, and should be affirmed.

II. Infringement Under the Doctrine of Equivalents

Assuming that customers in the United States have been induced to add connecting plates to the Powergrid, as was found by the jury, then the next question is whether substantial evidence supports the jury's verdict that the Powergrid, as modified, infringes under the doctrine of equivalents. In addition to the evidence already discussed, the testimony of Neil Suitor and Professor Slocum proves infringement under the doctrine of equivalents.

Suitor testified that Powerscreen "provided a series of bolt holes which we fit the two plates we've talked about with high tensile bolts originally connecting the top and bottom deck together *and that gives us virtually a one piece center plate design*, and by doing that we reduce the vibration of that design by a further 50 percent" (emphasis added). Powerscreen concedes that its one piece center plate design, allegedly only sold in Europe, would infringe claim 1 of the '000 if sold in the United States; Suitor's testimony concedes that the center plate design with the connecting plate is virtually the same thing.

Likewise, Professor Slocum testified as follows:

> Q. And when the plate is bolted in place, visualizing that structure, could you compare that with the plate as defined by the Court in the definition that the Court gave?
>
> * * * * * *
>
> A. And when the front center plates are bolted to the top and the bottom plates, and now we've got one, two, there's two side plates, three, four plates, all assembled, I think it will match, literally the judge's interpretation. And you will have a structure that has 95 percent the efficiency of, if we just took one single plate like Read uses and welded it in there.

In addition, Mr. Read, who appeared at trial as both a fact witness and an expert, testified as follows:

> Q. Now, what would that plate do if it were bolted up?
>
> A. Well, it would form—it would certainly serve as a—the strength of a full center plate, because it was attached on the back side, came all the way to the front, attached on the front side, it would transmit the strength from the top deck, those big beams, down to the bottom deck. Because the plate underneath the bottom went all the way down, it stuck down quite a bit, it was quite a strong plate underneath the whole structure there.

This testimony, along with the documentary evidence and testimony previously discussed with respect to inducement, in my opinion, establishes that the Powerscreen device is insubstantially different from the claimed centerplate, when its upper and lower centerplates are bolted together at the front end. The jury's verdict of infringement under the doctrine of equivalents should be affirmed based on this evidence.

In addition, I believe the jury's verdict of infringement under the doctrine of equivalents can be affirmed even without the addition of a connecting plate. While the majority correctly notes that Professor Slocum con-

ceded that such a structure would be inefficient, he did not concede that such a structure was not equivalent. In addition to the testimony identified in the majority opinion, Professor Slocum also testified as follows:

> THE COURT: You've read over that claim, correct?
> THE WITNESS: Yes, I have, sir.
> THE COURT: Now, you think you've got an understanding of it?
> THE WITNESS: Yes, I do, sir.
> THE COURT: And is it correct to say that you don't find exactly that plate in the Kentucky machine?
> THE WITNESS: You mean the plate that's in the claim?
> THE COURT: Right.
> THE WITNESS: It's not -
> THE COURT: You don't find that in the Kentucky machine?
> THE WITNESS: It's not an exact literal plate.
> THE COURT: Okay. Now, what do you find in the Kentucky machine that's like that plate and how like is it?
> THE WITNESS: Okay. Can I use my laser pointer?
> THE COURT: Go ahead.
> THE WITNESS: What I find is here is a center plate that joins together all the upper cross beams.... But in the back lever is where—okay, then you see the center plate here joining the lower, the lower beams? And this fin that sticks up, so now it splits the lower screen into two, two individual screens. And right in the back here is where, if you will, the center plate for the top screen and the center plate for the bottom screen are actually welded together back there.
> So what you get is a very inefficient, if you will, structure that will partially couple, via this particular center plate, the upper screen to the lower screen.

In my view, this testimony explains Mr. Slocum's later testimony on redirect that the unbolted center plate

structure "inefficiently performed the function" of the claimed centerplate. *See* Opinion p. 7 (discounting this testimony as merely conclusory). Mr. Slocum's testimony taken as a whole provides sufficient evidence for the jury to conclude that the unbolted center plate design performs the function of the claimed center plate through their connection to the back of the screen box. In addition to this testimony about the function of the unbolted center plate design, Mr. Slocum (and other witnesses) thoroughly explained the structure of the center plate design, pointing to photographs of the center plates and explaining their operation. These photographs and the diagrams of the center plates are additional evidence of infringement from which the jury could clearly understand the structure of the center plates.

My interpretation of Mr. Suitor's testimony also differs from the majority's interpretation. Mr. Suitor testified that the center plate design "rigidly connects the cross beams on each deck and transmits the forces from one to the other and into the back plate." The majority interprets this statement as meaning that one center plate connects the upper crossbeams and another center plate connects the lower crossbeams. But Mr. Suitor's testimony could be interpreted to mean that the center plates transmit "the forces from one [deck] to the other [deck] and into the back plate." So understood, Suitor's testimony is evidence that the center plate design transmits forces among the upper and lower decks' cross beams. Mr. Suitor also testified about the result of using a center plate: to strengthen the screen box. While Mr. Suitor would not concede that using the unbolted center plates provided as much strength as a single center plate, he did testify as follows:

> Q. Why is that plate included in the screen box at all?
> A. It's used to connect the cross beams which run transversely to each other.
> Q. Does it strengthen the screen?

A. Yes.

Thus, while Mr. Suitor and Mr. Slocum may have provided testimony that appears ambiguous or conflicting at times, our perception of these ambiguities may be a result of our having only a transcript to read. The witnesses' live testimony at trial, accompanied by reference to documents and photographs, may have been abundantly clear to the jury, and it is their job, not ours to evaluate the contradictory evidence and draw inferences therefrom.

In my opinion, when all of the evidence is considered in this case, substantial evidence supports the jury's verdict of infringement. I would therefore affirm the judgment of infringement.

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

THE READ CORPORATION,
F.T. READ & SONS, INC., and
NORDBERG-READ, INC.,
Plaintiffs,

v.

POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION LTD. and POWERSCREEN INTERNATIONAL, PLC,
Defendants.

CIVIL ACTION
No. 96-11025-WGY

FINAL JUDGMENT

Following the trial of this action, the jury having returned a verdict on February 28, 2001, this Court having thereafter considered Read's Motion for Prejudgment Interest, Read's Motion for Enhanced Damages Pursuant to 35 U.S.C. § 284, Read's Motion for Attorney's Fees and Expenses, Defendants' Renewed Motion for Judgment as a Matter of Law or, in the Alternative, for a New Trial, Read's Renewed Motion for Judgment as a Matter of Law, Defendants' Renewed Motion for Judgment as a Matter of Law or, in the Alternative, for a New Trial as to the Jury's Finding of Willful Infringement and the filings and argument in connection with said motions and, following hearing, on May 17, 2001, the Court having ruled upon said motions in open court,

IT IS HEREBY ORDERED, ADJUDGED AND DECREED:

1. That Defendants, Powerscreen of America, Inc., Powerscreen International Distribution, Ltd. and Powerscreen International, Plc (collectively "Powerscreen"), having infringed United States Letters

Patent No. 4,237,000, shall pay to Plaintiffs, The Read Corporation, F.T. Read & Sons, Inc. and Nordberg-Read, Inc. (collectively "Read"), $14,483,320, in compensatory damages, plus $14,483,320, said compensatory damages having been doubled pursuant to 35 U.S.C. § 284, plus $1,025,140.89 in costs and attorney's fees, plus $4,929,958.20 in pre-judgment interest on the compensatory damages through May 24, 2001 for a total of $34,921,739.09.

2. Powerscreen has not infringed United States Letters Patent No. 4,256,572.

3. Defendants' Renewed Motion for Judgment as a Matter of Law or, in the Alternative, for a New Trial, Read's Renewed Motion for Judgment as a Matter of Law and Defendants' Renewed Motion for Judgment as a Matter of Law or, in the Alternative, for a New Trial as to the Jury's Finding of Willful Infringement are denied.

4. The Order granting Plaintiffs' Motion to Restrain and Enjoin Transfers by Defendants, entered on February 28, 2001, is hereby vacated.

May 29, 2001 S/ William G. Young_____
William G. Young,
United States District Judge

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

THE READ CORPORATION,
F.T. READ & SONS, INC., and NORDBERG-READ, INC.,
Plaintiffs,
v.
POWERSCREEN OF AMERICA, INC.,
POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD.,
and POWERSCREEN INTERNATIONAL, PLC,
Defendants.

CIVIL ACTION
No. 96-11025-WGY

Excerpt from Transcript
Hearing on Post-Trial Motions
May 17, 2001.

[2] (Call of the civil motion list.)
THE CLERK: Calling Civil Action 96-11025, Read v. Powerscreen.

* * *

[16] THE COURT: All right. Thank you. I understand the argument. I'm going to stick to my time period. I think I am in a position to make rulings now and I'm going to make them.

First, as to the plaintiff's motion for judgment as matter of law, that motion is denied. It's denied first because it is the plaintiff on this issue that bears the burden of proof as to all elements of its case. I have no question about the construction I've given to the patent, and I'm not so glib as to think that no question could be raised as to the charge, but I'm satisfied with the charge, I'm satisfied with my explanation, that the matter was fully and fairly tried to the jury, and as to the '572 patent

Read lost.

In my mind it stretches the procedural rules beyond all bounds to start granting, even where they had exemplars of the device, they were largely undisputed, I agree with that, before them, it's for the jury to make these determinations.

Alternatively, I just reject your argument, Mr. Pirozzolo, that Festo here, the actual holding in Festo [17] would not prevent you from obtaining a verdict even if I'm wrong on my primary holding.

All right. Now, for the defendant Powerscreen's motion for judgment notwithstanding the verdict, with all respect, that motion is denied. If the doctrine of equivalents has any remaining vitality, this is a case where the doctrine of equivalents is appropriately applied. It's appropriately charged. This is not a case where a structural limitation prevents--

Well, I should say this. I, I am not in any way relying upon an alleged procedural default on the part of Powerscreen. And I don't mean to say that Read cannot raise this in further proceedings. But I do not rely on it. I stand on what I said about familiarity with Festo and reading and writing about Festo. It's fair to say, Mr. Pirozzolo says that the court was blindsided, I cannot say that I focused on this argument with the precision that able counsel has post verdict. I'm not saying that. I'm just saying that I think that the challenge to the Court's rulings were timely and adequately made so that I would have, should have been put on notice properly to follow the law. So we, we must deal with the law on its merits, it seems to me, not as a procedural matter. And I, and I do so.

But doing so, and with utmost respect, I just [18] reject Mr. Frank's argument. It seems to me that this is not a question of some structural limitation in the patent. This is a clear, in the Court's judgment, a clear and convincing equivalent which functioned in the same manner to accomplish the same result in the same way.

And so the motion for judgment as matter of law for the, or notwithstanding the verdict or for a new trial on the part of Powerscreen is denied.

This is willful infringement, willful infringement, which, in the Court's view, requires a sanction. The Court -- the judgment of this Court, on the trial record before it, Powerscreen was willfully infringing the Read patent to break into what it believed was a lucrative market. It had no reasonable basis for drawing the conclusion that its minor changes in any way designed around the patent. Its post hoc rationalizations and alleged references to patent practitioners, not lawyers, are both minimal and completely unpersuasive and in the eyes of the Court little more than a smokescreen.

Now, therefore, the Court doubles the damages found by the jury. I don't triple them. I double the damages. That's an adequate sanction against Powerscreen for this egregious conduct.

Next, there's the issue of prejudgment interest, a matter ultimately in the discretion of the Court, but the [19] default position in such a case is that there should be pretrial interest. I do so rule and award prejudgment interest at the T-Bill rate not compounded. The United States Treasury Bill rate over the course of the period not compounded.

Lastly there's the issue of attorneys' fees. Again, this is a matter within the informed judgment of the Court and it would be within the discretion of the Court to deny attorneys' fees. I do, however, consider this an exceptional case as established by clear and convincing evidence, a case in which attorneys' fees are warranted by the misconduct of Powerscreen.

The attorneys' fees will be calculated, as follows. There will be no enhancement over the actual attorneys' fees paid by Read. So the attorneys' fees are the actual attorneys' fees with the following subtractions.

All of the attorneys' fees up to the point when the triple zero patent emerged in the lawsuit are disallowed.

All of the attorneys' fees which have to do with the Festo case are disallowed. But in all other respects the fees and all of the costs are allowed in this case.

Now, I recognize that such a declaration is somewhat imprecise. I think, however, that the Court need go no further. In a way these fees are a sanction for [20] misconduct. And the Court is satisfied that attorneys' fees calculated in the manner I have set out adequately protects Read against having to bear the attorneys' fees to go after a willful infringer in an exceptional case and does not provide Read with a windfall over matters where Read, the attorneys' fees were on issues which were lost.

Counsel will prepare a form of judgment and upon the entrance of that judgment-- and I expect that to be done forthwith, Mr. Pirozzolo. You confer with Mr. Frank on the form of the judgment. Mr. Frank, I'm not asking for you to approve it, but I think I've set forth parameters so it can be calculated. By allowing it to come to me you concede nothing. All your rights and the rights of Powerscreen are reserved here on appeal. And upon the entry of that judgment the equitable order that the Court has, that Judge Tauro entered and which I have left in effect that dissolves.

That's the order of the Court. We'll recess.

* * *

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

01-1453,-1454

THE READ CORPORATION,
F.T. READ & SONS, INC., and NORDBERG-READ, INC.,
Plaintiffs-Cross Appellants,

v.

POWERSCREEN OF AMERICA, INC.,
POWERSCREEN INTERNATIONAL DISRIBUTION, LTD.,
and POWERSCREEN INTERNATIONAL, PLC,
Defendants-Appellants.

ORDER

United States Court of Appeals for the Federal Circuit

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the CROSS-APPELLANTS, and a response thereto having been invited by the court and filed by the APPELLANTS, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on October 17, 2002.

FOR THE COURT,

S/ Jan Horbaly
Jan Horbaly
Clerk

Dated: October 10, 2002
FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
OCT 10 2002

JAN HORBALY
CLERK

cc: Robert S. Frank, Jr.
Jack R. Pirozzolo
READ CORP V POWERSCREEN, 01-1453,-1454
(DCT - 96-CV-11025)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

United States Court of Appeals for the Federal Circuit

01-1453,-1454

THE READ CORPORATION,
F.T. READ & SONS, INC., and NORDBERG-READ, INC.,

Plaintiffs-Cross Appellants,

v.

POWERSCREEN OF AMERICA, INC.,
POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD.,and POWERSCREEN INTERNATIONAL, PLC,
Defendants-Appellants.

JUDGMENT

Appeal from the United States District Court for the District of Massachusetts
in 96-CV-11025, Chief Judge William G. Young.
This CAUSE having been heard and considered, it is ORDERED and ADJUDGED:

AFFIRMED in PART and REVERSED in PART.

ENTERED BY ORDER OF THE COURT

DATED: *AUG 7 2002*

*S/ Jan Horbaly*_____.
Jan Horbaly, Clerk

ISSUED AS A MANDATE: October 17, 2002

Constitution of the United States
Amendment VII

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

RULE 50
FEDERAL RULES OF CIVIL PROCEDURE

Rule 50. Judgment as a Matter of Law in Jury Trials; Alternative Motion for New Trial; Conditional Rulings

(a) Judgment as a Matter of Law.

(1) If during a trial by jury a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the issue against that party and may grant a motion for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue.

(2) Motions for judgment as a matter of law may be made at any time before submission of the case to the jury. Such a motion shall specify the judgment sought and the law and the facts on which the moving party is entitled to the judgment.

(b) Renewing Motion for Judgment After Trial; Alternative Motion for New Trial. If, for any reason, the court does not grant a motion for judgment as a matter of law made at the close of all the evidence, the court is considered to have submitted the action to the jury subject to the court's later deciding the legal questions raised by the motion. The movant may renew its request for judgment as a matter of law by filing a motion no later than 10 days after entry of judgment--and may alternatively request a new trial or join a motion for a new trial under Rule 59. In ruling on a renewed motion, the court may:

(1) if a verdict was returned:

(A) allow the judgment to stand,

(B) order a new trial, or

(C) direct entry of judgment as a matter of law;

or

(2) if no verdict was returned;

(A) order a new trial, or

(B) direct entry of judgment as a matter of law.

(c) Granting Renewed Motion for Judgment as a Matter of Law; Conditional Rulings; New Trial Motion

(1) If the renewed motion for judgment as a matter of law is granted, the court shall also rule on the motion for a new trial, if any, by determining whether it should be granted if the judgment is thereafter vacated or reversed, and shall specify the grounds for granting or denying the motion for the new trial. If the motion for a new trial is thus conditionally granted, the order thereon does not affect the finality of the judgment. In case the motion for a new trial has been conditionally granted and the judgment is reversed on appeal, the new trial shall proceed unless the appellate court has otherwise ordered. In case the motion for a new trial has been conditionally denied, the appellee on appeal may assert error in that denial; and if the judgment is reversed on appeal, subsequent proceedings shall be in accordance with the order of the appellate court.

(2) Any motion for a new trial under Rule 59 by a party against whom judgment as a matter of law is rendered shall be filed no later than 10 days after entry of the judgment.

(d) Same: Denial of Motion for Judgment as a Matter of Law. If the motion for judgment as a matter of law is denied, the party who prevailed on that motion may, as appellee, assert grounds entitling the party to a new trial in the event the appellate court concludes that the trial court erred in denying the motion for judgment. If the appellate court reverses the judgment, nothing in this rule precludes it from determining that the appellee is entitled to a new trial, or from directing the trial court to determine whether a new trial shall be granted.

No. 02-1053

FILED
FEB 12 2007

IN THE

Supreme Court of the United States

THE READ CORPORATION, F.T. READ & SONS, INC., AND NORDBERG-READ, INC.,

Petitioners,

v.

POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD. AND POWERSCREEN INTERNATIONAL, PLC,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ROBERT S. FRANK, JR.
ERIC J. MARANDETT
CHOATE, HALL & STEWART
53 State Street
Boston, MA 02109
(617)248-5000

RICHARD G. TARANTO *
FARR & TARANTO
1220 19th Street, N.W.
Suite 800
Washington, D.C. 20036
(202) 775-0184

* Counsel of Record

WILSON-EPES PRINTING CO., INC – (202) 789-0096 – WASHINGTON, D.C. 20001

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
BRIEF IN OPPOSITION	1
STATEMENT	2
ARGUMENT	8
A. Certiorari Should Not Be Granted With Respect to The Sufficiency Of The Evidence Question	8
B. Certiorari Should Not Be Granted With Respect To The Preservation Of Issues Question	14
CONCLUSION	16

TABLE OF AUTHORITIES

CASES — Page

Augustine Medical, Inc. v. Gaymar Industries, Inc., 181 F.3d 1291 (Fed. Cir. 1999) 13

Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303 (Fed. Cir. 1998) 13

Correa v. Hospital San Francisco, 69 F.3d 1184 (1st Cir. 1995) 15

Festo Corp. v. Shoketsu Kinzoko Kogyo Kabushiki Co., 535 U.S. 722 (2002) 13

Galloway v. United States, 319 U.S. 372 (1943) ... 12

Hoechst Celanese Corp. v. BP Chemicals Ltd., 78 F.3d 1575 (Fed. Cir. 1996) 15

Johnson & Johnston Associates, Inc. v. R. E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002) 13

Malta v. Schulmerich Carillons, Inc., 952 F.2d 1320 (Fed. Cir. 1991) 7, 14

Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996) 13

Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir. 1995) 13

Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420 (Fed. Cir. 1997) 13

Texas Instruments, Inc. v. Cypress Semiconductor Corp., 90 F.3d 1558 (Fed. Cir. 1996) 7, 14

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997) 7, 8, 9, 12

Weisgram v. Marley Co., 528 U.S. 440 (2000) 12

STATUTES

35 U.S.C. § 112 13

RULES

Fed. Cir. R. 47.6 6

IN THE

Supreme Court of the United States

No. 02-1053

THE READ CORPORATION, F.T. READ & SONS, INC., AND NORDBERG-READ, INC.,

Petitioners,

v.

POWERSCREEN OF AMERICA, INC., POWERSCREEN INTERNATIONAL DISTRIBUTION, LTD. AND POWERSCREEN INTERNATIONAL, PLC,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

BRIEF IN OPPOSITION

The petition seeks review of a non-precedential decision of the United States Court of Appeals for the Federal Circuit holding (1) that the evidence in this case was insufficient to support a jury verdict of infringement under the doctrine of equivalents, and (2) that respondents' pre-verdict motion for judgment as a matter of law adequately preserved their challenge to the sufficiency of the evidence of infringement. The first issue turns entirely on the application of routine legal principles to the unique factual record in this case. The second involves an evaluation of the wording of a particular pretrial motion. The decision is unpublished, presents no

legal issue of general applicability, and does not even arguably create a conflict among the circuits. The petition should be denied.

STATEMENT

1. Petitioner's United States Patent No. 4,237,000 (the '000 patent) describes and claims a component of a screening apparatus that separates excavation material into its fine (*e.g.*, loam and gravel) and course (*e.g.*, rocks and stumps) constituents. The screening device includes a "shaker assembly." The shaker assembly is generally rectangular in shape. It has a three-sided frame, consisting of two side plates that run from the front to the rear of the assembly and a back plate that traverses the rear of the structure and connects the side plates. Inside the frame are two levels of screens. The upper screen is of widely-spaced mesh. The lower screens are of a finer mesh. Each screen layer rests on a row of cross beams that run from one side of the shaker assembly to the other and are welded to the side plates. Thus, the device includes two tiers of cross beams—an upper tier on which the upper screen rests and a lower tier on which the lower screens rest. The entire shaker assembly slopes downward from the rear to the front of the earth screening device. A motor causes the shaker assembly to shake. *See* '000 Patent, Fig. 1, A200202-210 ("A" citations are to the appendix in the Federal Circuit proceedings).

A standard payloader dumps excavation materials into the screening apparatus from the rear. Course materials are unable to pass through the widely-spaced upper screen. They slide down the screen and fall to the ground at the front of the device. Less course materials pass through the upper screen onto the finer mesh lower screens. Rocks and debris that are too large to penetrate the lower screens slide down those screens and fall to the ground at the front of the apparatus.

Fine materials (loam and gravel) pass through the fine mesh lower screens and are captured inside the body of the device. They may then be removed and carried away. *See* A200008.

The '000 patent claims an alleged improvement to the prior art device described above. The improvement is the addition of a rigid longitudinal centerplate that runs down the middle of the shaker assembly from the rear to the front, parallel to the sideplates. Each of the upper and lower cross beams passes through, and is welded to, the centerplate. The centerplate is rigid. As a result, it holds all of the cross beams, upper and lower, in a fixed relationship to one another. When a load of construction debris is dumped on the shaker assembly, the centerplate distributes the resulting forces over all of the upper and lower cross beams so that each upper cross beam supports all of the lower cross beams, and each lower cross beam supports all upper cross beams. In addition, because the rigid longitudinal centerplate holds all of the cross beams in a fixed relationship, it causes the two screen decks to vibrate in unison when a load of earthen materials is dumped on the shaker assembly. This prevents out-of-phase vibration which, if it occurs, places intolerable stresses on the shaker assembly. A100862-63.

2. Claim 1 of the '000 patent, the only independent claim, states:

> In a shaker assembly for separating fine material from coarse material comprising longitudinal side plates, structural cross beams joining the side plates, a screen assembly spanning the space between the side plates and supported by the cross beams, and means for shaking the plates, cross beams and screen assembly, the improvement of:
>
> an upper screen assembly supported on an upper level of cross beams and a split lower screen assembly supported on a lower level of cross beams; and at least one *rigid longitudinal* center plate generally parallel to and between the side plates and *joining* the *upper and lower*

> *levels of structural cross beams such that forces applied to the screen assembly are transmitted through the center plate to the joined cross beams.*

See Pet. 5 (emphasis added).

The District Court construed this claim as requiring (1) a rigid longitudinal centerplate that (2) joins all of the upper and lower cross beams, (3) transmits forces applied to the shaker assembly to, and spreads those forces over, all of the upper and lower cross beams, and (4) prevents out-of-phase vibration of the screen decks. A100096-97, A101809-10. No objection was made to this claim construction at trial; and none was made on appeal. *See* A100927.

3. Respondents' accused device, called the Powergrid, includes a shaker assembly that, like the prior art, has side plates, a back plate, a wide-mesh upper screen supported by cross beams and fine-mesh lower screens, supported by a separate set of cross beams. A101592-101593. The Powergrid, however, did not have a rigid centerplate which joined the upper and lower levels of cross beams and held them in a fixed relationship so that forces were distributed over all cross beams and the screen decks would vibrate together.

Rather, the Powergrid had an upper centerplate, which provided support for its upper cross beams, and a distinct lower centerplate, which supported its lower cross beams. The upper and lower centerplates were each welded to the back plate (with a 3-inch attachment at the back plate). There was no other connection between the two centerplates anywhere along their seven foot-long length as they ran from back to front of the screenbox. As a result, the front end of one centerplate was free to, and did, move up and down independently of the front end of the other centerplate. Petitioners argued that the combination of these two

centerplates, forming a very elongated U-shaped structure when joined at the back, infringed the '000 patent under the doctrine of equivalents.

Petitioners' expert witness, Alexander Slocum, actually testified at trial to the *differences* between the claimed and accused structures. He explained that, unlike the single, rigid centerplate of the '000 patent, the Powergrid's structure allowed the fronts of the centerplates "to wobble up and down or deflect up and down" and permitted the "top structure" to vibrate at a "different frequency" from that of "the lower." A100897-898. The "large displacements" of the centerplates, the "motion occurring *between* the upper and lower decks," and the resultant "bowing" of the cross beams (*i.e.*, the bending of the cross beams at or near their mid-points) and out-of-phase vibration, caused cracking of the Powergrid's shaker assembly. A100897-898, A-100901, A100903-904, A100907.

The importance of the difference between the claimed rigid centerplate and the accused open-front structure (which allowed "motion occurring between the screen decks") was highlighted by petitioners' case against the version of the Powergrid that was introduced in 1997, shortly before the '000 patent expired. The 1997 structure included a series of bolt holes at the front ends of each centerplate. Petitioners argued that the bolt holes were intended to induce infringement because they invited users to install plates that would connect the otherwise separate front ends of the Powergrid's upper and lower centerplates. In support of that claim (which ultimately failed because there was no evidence that anyone in the United States ever installed the hypothetical front-connecting plates), petitioners' expert explained that it was a "very important structural goal in a machine like this to try and make the top and bottom [center]plate [structure] as rigid as possible so they shake as a rigid body without this breathing mode"—*i.e.*, without the

"up and down" movement of the front ends of the centerplates in opposite directions. A100898. Petitioners stressed that the attachment of front-connecting plates using the bolt holes would solve this serious problem. This testimony confirmed the substantiality of the difference between a structure having, and a structure lacking, a front connection that would unify the Powergrid's upper and lower centerplates and thus its cross beams and screen decks. A100901-905.

4. The jury found that the Powergrid's centerplates, without their front ends connected, did not literally infringe the '000 patent, but did infringe under the doctrine of equivalents. It also found respondents liable for inducing infringement. The district court denied respondents' pre-verdict and post-verdict motions for judgment as a matter of law, each of which asserted that there was insufficient evidence of infringement. In the post-verdict context, the district court specifically concluded that respondents' pre-verdict motion had adequately presented this issue. A101942.

5. The Court of Appeals reversed, in an unpublished opinion (which is therefore nonprecedential, Fed. Cir. R. 47.6). The court first agreed with the district court that respondents preserved their challenge to the sufficiency of the evidence of infringement under the doctrine of equivalents. Pet. App. A3. It observed that, although the "primary focus" of respondents' pre-verdict motion was on the inducement question (*i.e.* whether anyone had ever installed front-connecting plates using the bolt holes), the pre-verdict motion expressly and repeatedly asserted (in its introduction, headings, and conclusion) that there was not sufficient evidence of any infringement. Pet. App. A2-A3. The court noted that it is a patent-specific question—and hence a matter of Federal Circuit law—whether an assertion that there is no evidence of patent infringement suffices to preserve a claim that there is (more particularly) no evidence of infringement

under the doctrine of equivalents. Pet. App. A3 n.1. The court held that, under long-established Federal Circuit precedent, respondents' motion was sufficient. Pet. App. A3, citing *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1324-25 (Fed. Cir. 1991) (oral motion disputing the sufficiency of the evidence of infringement preserves appellate rights as to both literal infringement and infringement under the doctrine of equivalents); *Texas Instruments, Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566 n.6 (Fed. Cir. 1996) (same).

On the merits, the court began with a recitation of the substantial evidence test in routine terms. It followed with a statement of the standards applied to a claim of infringement under the doctrine of equivalents drawn from this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 (1997). The opinion included a description of the "function and way and result" approach that petitioners themselves used in trying to establish equivalence. Pet. App. A3, A4. Petitioners do not challenge those statements of the law. The Court of Appeals then applied those standards to the record in this case, conducting a lengthy review of the trial testimony, to determine if indeed there was sufficient evidence that the accused device included the equivalent of each limitation in the claims. Pet. App. A4-A12. The Court concluded that there was not. Pet. App. A4-A5 ("After carefully reviewing the testimony . . . we conclude that Read failed to elicit the evidence necessary to support the jury's finding of infringement under the doctrine of equivalents").[1] Having decided the appeal on the narrowest available ground —an evaluation of the sufficiency of the particular evidence

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[1] The court also held that petitioners failed to present sufficient evidence of inducement to infringe, because an essential element—actual installation of a front-end connecting plate, and thus the creation of an infringing structure by *someone*—was wholly unproved. Pet. App. 13. That ruling is not challenged in the petition.

offered at trial—the court had no occasion to determine whether the jury verdict of infringement by equivalents was also impermissible on the ground that it vitiated one or more claim limitations. Pet. App. A12.

Petitioners sought panel and *en banc* rehearing on the grounds now raised in this Court. Rehearing was denied.

ARGUMENT

Petitioners' challenge to the Court of Appeals decision is wrong on the merits, and, in any event, unworthy of review by this Court. The unpublished decision has no precedential value. It contains no significant legal rulings. No conflict of the circuits has been, or could be, suggested. The Court of Appeals applied undisputed legal standards. It performed a careful review, on an element-by-element basis, of the equivalents evidence—precisely what this Court has said should be done in cases of this type. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39 n.8 (1997) (stressing importance of summary judgment and JMOL review). Its decision is an utterly fact-specific application of settled legal standards regarding infringement by equivalents and the preservation of arguments for post-verdict review. The petition should therefore be denied.

A. Certiorari Should Not Be Granted With Respect To The Sufficiency Of The Evidence Question

1. The Court of Appeals correctly concluded that the evidence did not support a finding of equivalence. The claims of the '000 patent required, *inter alia*, a rigid longitudinal centerplate that joined the upper and lower cross beams. At trial, petitioners argued that the combination of the Powergrid's upper centerplate, which is connected to the Powergrid's backplate, and its lower centerplate, also connected to the back plate, "joined" the Powergrid's upper

and lower centerplates. They asserted that this elongated U-shaped structure was the equivalent of the claimed unitary centerplate. Under *Warner-Jenkinson*'s requirement of element-by-element equivalence, and the District Court's uncontested claim construction, this accused structure had to be the equivalent of a structure that (1) was "rigid," (2) prevented out-of-phase vibration of the two screen decks, and (3) distributed the forces initially imposed by a load of construction debris over all upper and lower crossbeams. Petitioners did not offer evidence that could have established any such equivalence.

The Court of Appeals explained carefully that petitioners' expert, Professor Slocum, stated nothing but bare conclusions as to function, way, and result. The petition does not appear to argue, and certainly does not demonstrate, otherwise. Pet. App. A6-A7. Far from satisfying petitioner's burden of proof, Professor Slocum's testimony affirmatively showed that the accused U-shaped construct, with no closure of the front ends, was seriously deficient, when compared to the claimed structure, precisely because it allowed Powergrid's upper and lower centerplates to move up and down in opposite directions, did not prevent out-of-phase vibration, and permitted bowing of the cross beams within each level, all of which repeatedly resulted in the failure of the Powergrid's shaker assembly. Professor Slocum's demonstrative aids even characterized the accused elongated U-shaped design, without front-end closure, as having "no effective center rib." A204044. This testimony was hardly accidental; it was the key underpinning of the petitioners' inducement case against the Powergrid's 1997 bolt hole design—which was premised on the prime importance of installing plates which would connect the front ends of the

Powergrid's separate upper and lower centerplates, and *thereby* create a rigid centerplate structure. As the Court of Appeals explained,

> Read introduced its inducement case through its expert, Mr. Slocum, who testified extensively as to the disadvantages of the Powergrid's centerplate structure. Specifically, he testified that Powergrid's dual centerplate structure allowed displacement between the screen decks, which resulted in cracking problems in the Powergrid shaker assembly. Accordingly, he advanced the theory that in 1997 Powerscreen introduced its "bolt hole" design to induce users to overcome the displacement between the Powergrid screen decks by bolting a connecting plate that joined the centerplates of each deck.

Pet. App. A5. There was not merely an absence of testimony establishing the *in*substantiality of the differences between the unitary, rigid, force-distributing, vibrative-synchronizing centerplate of the claims and the open-front structure of the accused device; there was testimony by the petitioners' expert that affirmatively demonstrated the substantiality of the differences.

In this Court, petitioners characterize certain witness testimony as meaning something the witnesses did not say. One excerpt (Pet. 7) is from respondents' employee, Neill Suitor. But, as the court below explained, this witness did not say that the Powergrid's centerplates transmitted forces from the upper to the lower cross beams (or vice versa); he said only that the upper and lower centerplates transmit forces among the cross beams *within each level*. Moreover, neither that excerpt, nor anything else, supplies (or could supply) the required evidence that the centerplates prevent out-of-phase vibration of the upper and lower screen decks. To the contrary, Mr. Suitor testified that Powergrid's separate

centerplate design allowed substantial out-of-phase vibration (a defect for which Powerscreen compensated by the use of other structural features). A101192-93.

A second excerpt from Mr. Suitor's testimony highlighted by petitioners (Pet. 7-8) is no more helpful to their case. As the Court of Appeals explained, the cited testimony says, and Mr. Suitor only reasonably could be understood to be saying, that the *screens* (not the *centerplates)* of the accused United States Powergrid design and the European Powergrid design (which, unlike the U.S. design, had front-end closure) performed the same function in the same way and achieved the same result. Pet. App. A10. Screens and centerplates are distinctly different structures, and Mr. Suitor had just finished testifying (two transcript pages earlier) that the front-closed (European) and front-open (United States) *centerplate* structures did *not* perform the same function. *See*, Pet. App. A10-A11.

Petitioners also point to an excerpt from the testimony of their expert, Professor Slocum. Pet. 9-10. That excerpt says that the Powergrid's upper centerplate joins its upper cross beams, that its lower centerplate joins its lower crossbeams, and that because the two centerplates are each welded to a back plate, there is an "inefficient" coupling of the screen decks. However, neither this statement, nor anything else in Professor Slocum's testimony, would allow a jury to conclude that the accused centerplate structure distributed forces initially imposed on one or a few cross beams over all cross beams, or performed the critical task of preventing out-of-phase vibration. To the contrary, as noted above, Professor Slocum characterized the Powergrid structure as non-rigid and as lacking any effective center-plate structure. *See supra* pp. 5-6, 9-10. As the Court of Appeals said, "the import of Mr. Slocum's testimony is that without a connecting plate [at the front end of its centerplates], the accused device was substantially inferior to the device recited in the patent. That

is not evidence of equivalence but of nonequivalence." Pet. App. A7-A8. The Court of Appeals thus correctly found no sufficient element-by-element evidence of equivalence.

2. In addition to being correct, the Court of Appeals' decision raises no issue of legal significance. Petitioners do not, and could not, suggest that the Court of Appeals misstated, or made new law respecting, the standards for infringement under the doctrine of equivalents. Rather, petitioners present a broad-brush attack on the Federal Circuit, arguing that its practice of reviewing the actual evidence in cases to ensure that it could reasonably be found to establish equivalence has eroded the Seventh Amendment's protection of the right to trial by jury. However, review of the sufficiency of the evidence, which goes on daily in federal appellate courts, has long been held to be perfectly consistent with the Seventh Amendment. *E.g.*, *Galloway v. United States*, 319 U.S. 372, 389 (1943); *See also Weisgram v. Marley Co.*, 528 U.S. 440, 450-452 (2000). And, whether the evidence actually is insufficient in a particular case necessarily depends on the facts of that case, a matter which is rarely of general legal significance, and certainly is not of broad significance in this case.

Petitioners supply no basis for the accusation that the Federal Circuit has lost its way in the course of performing precisely the sufficiency-of-the-evidence review that this court anticipated in *Warner-Jenkinson*, 520 U.S. at 39 n.8 (1997). Whether the evidence in the various cases petitioners cite was in fact insufficient would require a detailed, record-specific review of those cases, a task that petitioners do not even begin to undertake. Petitioners' argument amounts to nothing more than the meaningless observation that in a few other cases (a grand total of 7, according to petitioners, amidst the large number of Federal Circuit decisions in the last five years, Pet. 11, 17 n.10) the court has held that the plaintiff failed to offer sufficient evidence of equivalents.

Much of petitioners' remaining attack is simply beside the point. They point to various *legal* rulings in other Federal Circuit decisions on issues that are not presented in this case. For example, petitioners point to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), holding that claim construction is for the court (not the jury), but that issue is not presented here, and this Court has already reviewed and affirmed the Federal Circuit's position. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Petitioners cite *Johnson & Johnston Associates, Inc. v. R. E. Service Co.*, 285 F.3d 1046 (Fed. Cir. 2002), where the Federal Circuit held that subject matter disclosed, but not claimed, in a patent is dedicated to the public (unless included in the claims of a continuation application). That issue has no bearing on this case. Petitioners rely on *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303 (Fed. Cir. 1998), which addresses the doctrine of equivalents in the context of a means plus function claim (*see* 35 U.S.C. § 112, para. sixth); but the claims here are not means plus function claims, and *Chiuminatta* therefore has no relevance. Similarly, the ruling on the '000 patent in this case involves no issue relating to the "pioneering" status of an invention, as in *Augustine Medical, Inc. v. Gaymar Industries, Inc.*, 181 F.3d 1291 (Fed. Cir. 1999), and no issue of prosecution history estoppel, as in *Festo Corp. v. Shoketsu Kinzoko Kogyo Kabushiki Co.*, 535 U.S. 722 (2002). Likewise, the Court of Appeals in this case had nothing to say about (respondents' argument relying on) decisions like Sage *Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420 (Fed. Cir. 1997), which state that the doctrine of equivalents may not be used to vitiate a clear structural limitation in a patent claim. There is, in short, no significant legal issue presented in this case.

B. Certiorari Should Not Be Granted With Respect To The Preservation Of Issues Question

No significant issue is presented by the Court of Appeals' holding—which is correct—that respondents' pre-verdict motion adequately preserved their post-verdict right to challenge the sufficiency of the evidence of infringement under the doctrine of equivalents. Respondents' pre-verdict motion for judgment as a matter of law directly asserted at least three times that the evidence at trial was not sufficient to support a verdict of infringement, and it sought a judgment of non-infringement. A000107, A000113, A000114, A000115. On that record, the District Court squarely held that respondents had indeed challenged the sufficiency of the evidence of literal infringement and of infringement by equivalents. It said:

> I think the challenge to the Court's rulings were timely and adequately made so that I would have, should have, been put on notice properly to follow the law. So we, we must deal with the law on the merits, it seems to me, not as a procedural matter.

A101942. The Court of Appeals drew the same conclusion.

Both rulings followed established precedent holding that a simple, conclusory statement that the evidence does not support a verdict of infringement is sufficient to preserve a defendant's right of appeal with respect both to literal infringement and to infringement under the doctrine equivalents. *Malta*, 952 F.2d at 1324-25; *Texas Instruments*, 90 F.3d at 1566, n.6. These decisions reflect the elementary fact that arguing for a judgment of no infringement necessarily encompasses both literal and equivalents infringement. The Court's ruling is not only sensible, it is a matter peculiarly within the procedural competence of the Federal Circuit. Moreover, this precedent defined what a defendant must do to preserve a non-equivalents argument for appeal. It would be

particularly unfair for respondents now, retroactively, to be held to a different standard.

Petitioners cannot support a different result by arguing that the pre-verdict motion, though adequately alerting the District Court to the issue, did not alert petitioners' counsel. First, regardless of counsel's subjective state of mind, the motion was sufficient under clear precedent (here, coupled with the district court's recognition of the motion's content). Second, petitioners did not argue in the trial court or in their brief in the Court of Appeals that they relied on respondents' supposed forfeiture of the right to contend that the evidence of equivalents was insufficient. If petitioners had truly been prejudiced, they surely would have, and in any event should have, made a concrete showing of prejudice long before simply making that assertion in their petition for rehearing in the Court of Appeals.

Petitioners also suggest that the decision below is somehow at odds with First Circuit precedent that they say requires that a ground for judgment as a matter of law be "distinctly articulated." Pet. 24, citing *Correa v. Hospital San Francisco*, 69 F.3d 1184, 1196 (1st Cir. 1995). Even if the Federal Circuit's decision in the present case were precedential, there would be no conflict of the circuits. The question here is whether a direct (thrice stated) challenge to the sufficiency of the evidence of "infringement" in a pre-verdict motion is a challenge that includes both sub-categories of infringement, or whether a litigant is required to incant the additional words "literally or under the doctrine of equivalents." The resolution of that question is an issue of patent law on which the First Circuit has not pronounced, and that has repeatedly and properly been decided by the Federal Circuit. Review of this issue should be denied.[2]

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[2] Petitioners' argument that the decision in this case is at odds with the Federal Circuit's precedential decision in *Hoechst Celanese Corp. v. BP Chemicals Ltd.*, 78 F.3d 1575 (Fed. Cir. 1996), is similarly unavailing.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

ROBERT S. FRANK, JR.
ERIC J. MARANDETT
CHOATE, HALL & STEWART
53 State Street
Boston, MA 02109
(617) 248-5000

RICHARD G. TARANTO *
FARR & TARANTO
1220 19th Street, N.W.
Suite 800
Washington, D.C. 20036
(202) 775-0184

* Counsel of Record

Aside from the unpublished nature of the present decision, and the fact that such an intracircuit matter is not appropriate for this Court's review, the cases are materially different. In *Hoechst*, the defendants' pre-verdict motion argued only against a particular claim construction. The court was not presented with a general challenge to the sufficiency of the evidence of infringement of the type that was made in this case and that is addressed in the decision below.